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IN THE

Supreme Court of the United States

OCTOBER TERM, A.D. 1953

NO. 519

JEOFFROY MFG. INC., ROY JEOFFROY AND RAY L. JEOFFROY,
Petitioners,

VERSUS

WILLIAM T. GRAHAM AND GRAHAM-HOEME PLOW CO., INC., *Respondents*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT AND BRIEF IN SUPPORT OF PETITION

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To the Honorable Earl A. Warren, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

Your Petitioners respectfully show:

I. *Summary Statement of the Matters Involved.*

This is a patent infringement suit brought by William T. Graham and Graham-Hoeme Plow Co., Inc., Respond-

ents, against Jeoffroy Mfg., Inc., Roy Jeoffroy and Ray L. Jeffroy, Petitioners. Respondents alleged that William T. Graham was the owner of United States Letters Patent No. 2,493,811, issued January 10, 1950, for "Vibrating Plow and Mounting Therefor", that Respondent Graham-Hoeme Plow Co., Inc. was duly authorized to manufacture and sell the devices embodying the invention of said patent and that Petitioners were jointly and severally guilty of infringement of said letters patent and sought relief by way of injunction and damages. (R. 3-6)

Petitioners denied validity and infringement and alleged affirmatively, among other things, that the patent is invalid and void because of anticipation, lack of invention, prior disclosure, and because Graham was not the sole, first or original inventor but had surreptitiously obtained a patent for the invention of others (if there was any patentable invention present). (R. 7-12)

Trial was to the Court without a jury. On December 31, 1951, the Court filed findings of fact and conclusions of law (R. 20-29), and on January 5, 1952, entered judgment holding the patent valid and Claims 1, 2, 4, 5, 6, 7 and 8 thereof infringed by Petitioners. (R. 29-31)

Petitioners duly perfected appeal to the United States Court of Appeals for the Fifth Circuit, presenting both the questions of validity and infringement in that Court. The Court of Appeals in its decision, *Jeoffroy Mfg., Inc. et al, v. Graham et al*, 206 F. 2d 772, September 9, 1953, rehearing denied October 7, 1953, modified the judgment

of the Trial Court in respects not material here and affirmed the judgment as to validity and infringement. (R. 1355)

This writ is sought to review both the questions of validity and infringement.

II. *Jurisdictional Statement.*

The statutory provision believed to sustain the jurisdiction of this Court is Section 1254 of Title 28 of the United States Code. Jurisdiction is also sustained under the authority of *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147 (1950). The date of the judgment sought to be reviewed by certiorari is October 7, 1953, and the date of this application for certiorari is ~~January~~ December 31, 1954.

III. *Questions Presented.*

The questions herein presented are:

A. Did the courts below clearly err in applying standards of invention that were inappropriate or insufficiently exacting?

B. Did the courts below clearly err in holding Claims 1, 2, 4, 5, 6, 7 and 8 of the patent infringed by the Jeoffroy structure?

IV. *Reasons Relied on for the Allowance of the Writ.*

A. The courts below have failed to apply with sufficient strictness the criteria of invention laid down by this Court for a combination patent in *Great A. & P. Tea*

Co. v. Supermarket Equip. Corp., 340 U.S. 147 (1950), and the decisions below are in conflict with that decision.

B. The decisions below on the question of invention are in conflict in principle with the decision of the Court of Appeals for the Tenth Circuit in *Hutchinson Mfg. Co. v. Mayrath*, 192 F. 2d 110 (1951), cer. den. 343 U.S. 914, the decision of the Court of Appeals for the Eighth Circuit in *Continental Farm Equipment Co. v. Love Tractor*, 199 F. 2d 202 (1952), and the decisions of other Courts of Appeal following the *A. & P.* case.

C. The decisions of the courts below as to infringement are in conflict in principle with the decision of the Court of Claims in *Pratt v. United States*, 43 F. Sup. 461 (1942), cer. den. 302 U.S. 750, and the decision of the Court of Appeals for the Fifth Circuit in *Prince-Trawick v. Gas Lift Corp.*, 101 F. 2d 134 (1939).

D. The matter involved is of concern not only to these litigants but to the public at large in that the range of protection provided and the range of monopoly extended by the patent laws of the United States is involved.

WHEREFORE, your Petitioners pray that a writ of certiorari issue under the seal of this court, directed to the Court of Appeals for the Fifth Circuit, commanding said court to certify and send to this court a full and complete transcript of the record and of the proceedings of said court had in the case numbered and entitled on its docket, No. 14,227, *Jeoffroy Mfg. Inc., et al, Appellants,*

v. William T. Graham and Graham-Hoeme Plow Co., Inc., Appellees, to the end that this cause may be reviewed and determined by this court as provided for by the Statutes of the United States; and that the judgment herein of said Court of Appeals for the Fifth Circuit be reversed by this court, and for such further relief as to this court may seem proper.

DATED ~~January , 1954.~~ December 31, 1953.

W. W. Gibson

W. W. GIBSON

Attorney for Petitioners

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PLOW CO., INC., *Respondents*

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

I. OPINIONS OF THE COURTS BELOW.

The Trial Court did not file a formal opinion. Its findings of fact and conclusions of law appear at R. 20-29. Its letter to counsel advising the Court's decision appears at R. 14, and its letter to counsel making a fuller statement is attached to this brief as Appendix "A", p. 26.

The opinion of the Court of Appeals for the Fifth Circuit appears at R. 1355 and is reported in 206 F. 2d 772.

II. JURISDICTION.

A. The date of the judgment of the Court of Appeals for the Fifth Circuit to be reviewed is October 7, 1953, upon which date rehearing was denied. (R. 1374)

B. The statutory provision which is believed to sustain the jurisdiction of this Court is Section 1254 of Title 28 of the United States Code.

C. The questions presented for consideration here are not contingent upon resolving conflicting testimony. Resolving all conflicting testimony in Respondents' favor (except where specifically resolved against them by the Trial Court), the questions presented for review are whether the courts below have applied sufficiently appropriate and exacting standards of invention and infringement. *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147 (1950), squarely sustains jurisdiction.

III. STATEMENT OF THE CASE.

The general nature and outline of the case has already been stated in the preceding petition for review by certiorari under paragraph I (pp. 1-2) of said petition, which summary statement is here adopted and made a part of this brief.

A. The Patent in Suit

The patent No. 2,493,811 (R. 1024) is entitled "Vibrating Plow and Mounting Therefor" but relates specifi-

cally to a clamping device for mounting the shanks of ground working tools to the frame of the plow.

The device includes seven parts or elements: (1) a bracket 41 secured to the lower flange of an H or I-beam by means of a set screw 50; (2) a pivot pin 62 across the channel or way of the bracket at the rear thereof; (3) a fulcrum member 63 hinged or pivoted on the pivot pin; (4) a spring rod or bolt 71 inserted through openings in the bracket, the shank and the fulcrum member; (5) a coil spring 66 sleeved over the rod and seated on the bracket; (6) a washer 75 and nut 76 holding the spring in position, and (7) a shank.

The shank of the ground working tool lies between the bottom face of the bracket and the upper face of the fulcrum member. The purpose of the device is to permit the ground working tool to ride up and over rocks and other obstructions encountered in the ground and after clearing the obstructions to return to operating position. Additionally it is claimed that the devise provides a constant and continuous pumping action of the ground working tool.

B. Background of Development

Since about 1937 both petitioners and respondents and their predecessors have manufactured and sold generally similar chisel plows of H or I-beam frame construction with curved spring steel shanks attached to the frame by

various clamping means. Those plows equipped with rigid clamps had a chiseling or vibrating action of the plow tools in operation, resulting from the inherent resiliency of the curved spring steel shanks. (Finding of Fact XII, R. 23)

When the Graham chisel plow was put in use near Valley City, North Dakota, in the spring of 1946 serious breakage and bending of parts occurred because of rocks in the soil, and the need for a flexible clamp mechanism of some sort for each separate shank of the plow became urgent. Two local farmers then immediately and spontaneously constructed a device, which has been designated in this case as the "Valley City Device," in an effort to guard against such damage. (Finding of Fact XIII, R. 23) The Valley City Device is exemplified by drawings, Defendants' exhibits 80-A and 80-B (R. 1114) and Defendants' exhibits 87-A through H and 192-A through H, the originals of which have been transmitted to the court. A reproduced model thereof, Plaintiffs' exhibit 73, also has been transmitted to the court. There is evidence that Elmer Helfeld, Theodore Trautmann, Andrew P. Nelson, Michael K. Ulmen, and George R. Richter - one of Graham's salesmen - participated in the construction of the Valley City Device, but since the patentee Graham had no part in the construction, it is unimportant who made it, and that evidence will not be detailed.

The Trial Court found that the Valley City Device was made about March 26, 1946. (Finding of Fact X, R. 22) Graham's salesman, George R. Richter, was present when

the Valley City Device was made, and he immediately reported the event by telephone to Graham's home office in Amarillo, Texas. (Finding of Fact X, R. 22) Richter testified that he did not describe the device over the phone at all (R. 916, 935), though he was enthusiastic about it (R. 939), but the court found that Graham knew the general description of the Valley City Device when his employee Shelton was instructed to make the drawing, Defendants' exhibit 98 (R. 1172), which drawing is the earliest drawing of a spring clamp device produced by the Plaintiffs. (Finding of Fact X, R. 22). Mr. Shelton testified that the drawing, Defendants' exhibit 98, was the first drawing of a spring clamp, and he made that drawing about the time Mr. McKee started to work for Graham. (R. 307-308) Mr. McKee started to work for Graham about March 25 or 26, 1946. (R. 371, 378)

Graham testified that he had started working on ideas for a spring clamp as early as 1940, had made some pencil sketches, and completed his ideas for the spring clamp in the first part of 1945, making some further pencil sketches, though the sketches could not be produced, and no model was built until the Spring of 1946 after Mr. McKee went to work for the Company. (R. 160-162) The model, Plaintiffs' exhibit 34, is before the court. Second and third drawings are in evidence as Defendants' exhibit 99 (R. 1173) and Plaintiffs' exhibit 44 (R. 1053).

The Trial Court found that the Valley City Device was the first spring mechanism contrived for each separate

shank of a Graham plow, but that Graham had prior thereto given some thought to the rock problem and to the design for a spring clamp for his plow, including some pencil sketches, but had not yet matured his final conception and had not made any models of such a device. (Finding XIII, R. 23-24) The Trial Court apparently believed Graham's testimony that he had been studying the problem, but did not believe his testimony that he had completed his conception prior to his learning of the Valley City Device.

The witnesses, Elmer Helfeld, Theodore Trautmann, Andrew P. Nelson, Michael K. Ulmen - all residents of Valley City, North Dakota - and George R. Richter, Graham's salesman, described the construction of the Valley City Device, with some minor variations, in the following manner: A regular Graham rigid clamp - similar to that shown in Figs. 3, 4 and 5 of the Noell patent (R. 1222) - was cut with a cutting torch, the center web portion thereof being removed to permit the shank to move vertically. A section of hollow wrist pin was welded to each of the rear portions of the clamp and another section of wrist pin was welded to the top of the shank. The three wrist pin sections were lined up and a pin or bolt inserted therethrough to provide a hinge or pivot for the shank. A plate or strapiron was welded to the top flange of the I-beam with a portion of the plate extending forward of the I-beam for a coil spring to seat upon. A hole was cut in the forward end of the shank and in the for-

ward end of the plate on top of the beam. A short length of eye-bolt was inserted through the hole in the shank and fixed in position by a nut underneath the shank. The eye of the short bolt was linked with an eye of a longer bolt which was inserted through the hole in the plate on top of the I-beam. A coil spring was placed over the long portion of the eye-bolt and a washer and nut placed in position on top of the eye-bolt to hold the spring in position. Set screws or bolts were put through the two sides of the clamp to hold the clamp in position on the lower flange of the I-beam. The details of this construction are best illustrated by the drawings of Elmer Helfeld, Defendants' exhibits 87 - A through H and 192 - A through H, origina's of which have been transmitted to the court. (Since the variations in the construction details are not important and are not substantially in dispute, the record testimony of the witnesses is not pointed out.)

When the Valley City Device was tested in the field the day after it was built, it was found that the spring in use was too small, the limit of vertical travel when striking a rock was not sufficiently great, the set screws on the under side of the clamp did not provide adequate support to keep the clamp solidly in position or to prevent the shank from moving laterally when obstructions were encountered, and the welding was not strong enough, *but it did trip as expected.* (R. 257, 272 273, 279, 415, 443-444, 614) Shortly after the test of the Valley City Device, two other plows, the Ulmen plow, Defendants' exhibits

82 - A through E (R. 1150-54) and 84 - A through I (R. 1156-64), and the Holm plow, Defendants' exhibits 81 - A through E (R. 1145-49), were completely equipped with handmade spring trips in the Ulmen shop in Valley City, North Dakota, those trips having some variations to correct the defects which had been discovered in the original Valley City Device when same was tested in the field. (R. 406-416, 342-350, 444) Those two plows with homemade trips were used successfully until the homemade trips were later replaced with the Graham commercial trip (R. 433) and the Jeoffroy commercial trip (R. 344).

Elmer Helfeld testified (R. 615-33) that during the early part of April, 1946, he made some further modifications of the trip by constructing a box or sleeve to hold the shank in order to eliminate welding to the shank, and by providing a plate on top of the I-beam which was movable rather than welded in place. These devices are exemplified by Helfeld drawings, Defendants' exhibits 90-A and B and 91-A and B (R. 1168-1171). The witnesses Theodore Trautmann (R. 261, 280), John Helfeld (R. 392), Alfred R. Posterick (R. 545-556) and Martin Thilmony (R. 582-587), testified that Elmer Helfeld made one or more spring trip devices after the original Valley City Device was made. Graham offered no testimony to the contrary, but there was considerable controversy between counsel and the Trial Court found that the realty of the Helfeld device is open to skepticism and that in any event no more than three and likely only one was ever built.

(Finding XII, R. 21-23) The Helfeld device was not prior to Graham's final drawing dated April 3, 1946, Plaintiffs' exhibit 44 (R. 1053), which is substantially the same as that disclosed in the patent; consequently the Helfeld device is not presented as part of the prior art but merely as an item of mechanical adaptation by an ordinary farm boy following the first effort.

C. Prior Patent Art

Petitioners set up a number of prior art patents which are in evidence as Defendants' exhibit 139 (R. 1190-1264). Colored drawings of some of those patent disclosures and colored drawings of the Valley City Device and the Helfeld device are in evidence as Defendants' exhibits 185 through 204, the originals of which have been transmitted to the court.

The prior agriculture art, as set up and introduced in evidence by Petitioners, discloses, either singly or in varying combinations but never all in any one patent or device (Finding of Fact XV, R. 24-25), the following elements:

1. A bracket on a plow frame having an opening way, sometimes of channel-shaped formation, for accommodating a spring steel shank or other plow tool holder, some of which ways open downwardly and others upwardly;

2. A pivot pin designed to accommodate the pivotal movement thereabout of a spring steel shank or other plow tool holder;

3. A spring steel shank or other plow tool holder designed to pivot about a pivot pin attached to a plow frame or a bracket mounted upon a plow frame;

4. A spring rod with a coil spring thereabout designed to maintain a spring steel shank or other plow tool holder in resilient connection with the plow frame or a bracket mounted upon the plow frame;

5. A pivotal or fulcrum member designed for attachment to a spring steel shank or other plow tool holder and to permit such shank or tool holder to pivot about a pin or a pivot point upon the plow frame or a bracket attached to the plow frame.

Spring devices constructed to permit the ground tool holder of an agricultural implement to yield when rocks or other obstructions in the soil are encountered and to return the ground tool to working position after the obstruction is cleared where standard equipment on agricultural implements in the rocky territory (Trautmann, R. 288; Ulmen, R. 462; Thilmony, R. 584; Jeoffroy, R. 481, and Fenton, R. 232), and long before the Graham plows were introduced in the rocky territory there were agricultural implements with ground working tools disclosed in the patent art, described as vibrating or trembling in operation, and provided with spring release devices

to let each ground working tool yield when a rock or other obstruction was encountered in the soil and then after clearance return to operating position. (Finding of Fact XIV, R. 24)

D. Findings of Validity

The Trial Court found that none of the earlier patents cited nor the other devices introduced by Petitioners embodied the double fulcrum and other novel parts of the fulcrum assembly disclosed in the Graham patent (Finding of Fact XVI, R. 25), and upon the request of Petitioners' counsel the Trial Court further spelled out his findings of novelty in his letter to counsel dated April 12, 1952, and attached to this brief as Appendix "A" (p. 91). The Trial Court referred to a "special aspect of invention" in Finding of Fact XI (R. 22-23) and in his letter opinion (R. 14, at top of page 16). This special aspect of invention was spelled out in terms of novelty in the court's letter, Appendix "A", and the Trial Court of course made a general conclusion of validity (Conclusion of Law II, R. 28). But apparently the only specific attention to the question of invention and the only finding of invention by the Trial Court is wrapped up in the letter opinion (R. 16-17) where the Court considers the novelty of the fulcrum assembly coupled with the reputed suitability of the device to dig a scalloped pattern through the plowed earth to be sufficient to avoid the condemnation of the *A. & P.* case.

The Court of Appeals for the Fifth Circuit additionally held that independently of the Trial Court's findings of novelty the evidence fairly established that Graham was the first to perfect the idea of resilient and frictional engagement of the shank of a ground-working tool between a fixed part and a movable part thereby obviating the necessity of the shank being hinged directly on a fixed member as in the Valley City Device and in the prior art, which structure was novel both in method of operation and result accomplished, and the patent was not invalidated under the test laid down in the *A. & P. Tea Co.* case, since that case involved only uniting old elements with no change in their respective functions, whereas the patent here involved combines both old and new elements to produce a new result. (R. 1363-1364)

E. Infringement

Petitioners did not sell or distribute their chisel plows in the rocky territory until the Spring of 1947. At about that time Respondents' plows were being equipped with spring clamps as exemplified by the patent. About May 8, 1947, the Petitioner Ray L. Jeoffroy inspected one of Respondents' spring clamps in a field in North Dakota and within a matter of 48 hours made the first model of Petitioners' spring device. (Finding of Fact XX, R. 27-28) Ray Jeoffroy testified that the Graham plow he inspected was not operating in a satisfactory manner. The spring was too weak and the device was operating in

an open position most of the time. (R. 484-495, 498) Petitioners' spring devices are exemplified by Plaintiffs' exhibits 6, 7 and 37 which have been transmitted to the court.

Petitioners' spring device is structurally different from the patent in the following respects: (1) Two springs are used instead of one. (2) The spring rods do not pass through the shank. (3) The spring rods are not pivotally connected to the fulcrum member. (4) The spring rods do not attach the shank to the mounting and do not carry any of the pulling load of the shank. (5) The fulcrum member has a complete sleeve bearing on the pivot pin rather than a cradle or groove bearing. (6) The pivot pin carries the pulling load of the shank.

Based upon comparative field tests the Trial Court concluded that the Graham and Jeoffroy structures perform in a simiar manner but that there are performance differences in the amount, degree and continuity of pumping action of the ground working tools which differences result primarily from the variations in spring pressure of the two devices. (Finding XVII, R. 25-26) It should be noted that the comparative tests observed by the Trial Court were not on a parity with ordinary field use and operation in that only two shanks were mounted on a plow frame designed ordinarily to carry 8 or 10 shanks. (Finding XVII, R. 25-26)

Additionaliy the Trial Court found that in the Jeoffroy structure the only longitudinal movement between the

shank and the fulcrum member is that which is permitted by necessary manufacturing tolerances and operational wear in the nib and socket fittings of the shank, fulcrum member and bracket. No longitudinal movement is intentionally designed into said devices, and longitudinal movement is not necessary to the functioning of said devices. (Finding XVIII, R. 26-27)

The structural and functional differences were not regarded by the courts below as sufficient to avoid infringement.

IV. SPECIFICATION OF ERRORS.

A. The courts below clearly erred in holding that Graham patent No. 2,493,811 reveals patentable invention.

B. The courts below clearly erred in holding that Claims 1, 2, 4, 5, 6, 7 and 8 of Graham patent No. 2,493,-811 are infringed by the Jeoffroy structure.

V. ARGUMENT.

POINT A - INVENTION

Graham patent No. 2,493,811 is void for lack of invention. The patent reveals merely a combination which unites old elements with no change in their respective functions, with no unusual or surprising consequences from the unification, and with no total result that is more than the sum of the parts. The product is that of mechanical skill rather than invention.

To avoid all waste motion, let us at the outset recognize that the Graham patent discloses a useful device, for the device has permitted the use of the Graham plow in the rocky territories of the North and Northwest. We further recognize that the device has enjoyed commercial success - many thousands have been sold. Let us also eliminate from consideration the pure questions of anticipation and novelty and recognize that the patent reveals a structure novel in the sense that no prior art patent or device reveals precisely the same shape, form, position or arrangement of parts.

Novelty, utility and commercial success, however, do not make patentability. *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 95 L.Ed. 162, 71 S.Ct. 127 (1950); *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 86 L.Ed. 58, 62 S.Ct. 37 (1941); *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350, 83 L.Ed. 1334, 59 S.Ct. 897 (1939); *Thompson v. Boisse'ier*, 114 U.S. 1, 29 L.Ed. 76, 5 S.Ct. 1052 (1884); *Jacuzzi Bros. v. Berkeley Pump Co.*, 191 F. 2d 632 (C.A. 9, 1951).

There remains the vital question of whether there is invention.

The books are filled with statements of tests for determining invention. Those tests are well known to the Court and only a limited discussion will be had here. In the landmark case of *Atlantic Works v. Brady*, 107 U. S. 192, 27 L.Ed. 438, 2 S. Ct. 225 (1882), the court said:

> "The process of development in manufacturers creates a constant demand for new appliances, which the skill of the ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences."

Various statements of the rule or rules may be found in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 86 L.Ed. 58, 62 S.Ct. 37 (1941); *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 82 L.Ed. 1008, 58 S.Ct. 662 (1937); *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U.S. 350, 83 L. Ed. 1334, 59 S.Ct. 897 (1939); *Concrete Appliances Co. v. John E. Gomery*, 269 U.S. 177, 70 L.Ed. 222 (1925); *Dunbar v. Meyers*, 94 U. S. 187, 24 L.Ed. 34 (1876).

This honorable Court has recently and exhaustively examined the question of invention as applied to a combination patent in *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, 95 L.Ed. 162, 71 S.Ct. 127 (1950). As we construe that case the Court has laid down the rule that a combination of ~~all~~ old elements amounts to invention only when the unification of elements produces unusual or surprising consequences or produces a

unified whole which in some way exceeds the sum of its parts.

Practically all of the courts of appeal have recognized that the *A. & P.* case has hightened the test of invention for combination patents, and in following the rule there announced have struck down a combination patent for lack of invention. *United Specialties Co. v. Industrial Wire Cloth Products Corp.*, 186 F. 2d 426 (C. A. 6, 1951); *General Bronze Corp. v. Cupples Products Corp.*, 189 F. 2d 154 (C.A. 8, 1951); *Photochart v. Photo Patrol*, 189 F. 2d 625 (C.A. 9, 1951); *Hutchinson Mfg. Co. v. Mayrath*, 192 F. 2d 110 (C.A. 10, 1951), cer. den. 343 U.S. 914, 96 L.Ed. 553, 72 S.Ct. 647; *Pennsylvania Crusher Co. v. Bethlehem Steel Co.*, 193 F. 2d 445 (C.A. 3, 1951); *Whitman v. Andrus*, 194 F. 2d 270 (C.A. 6, 1952); *Packwood v. Briggs & Stratton Corp.*, 195 F. 2d 971 (C.A. 3, 1952); *Kobe, Inc., v. Dempsey Pump Co.*, 198 F. 2d 416 (C.A. 10, 1952); *Ingersoll-Rand Co. v. Black and Decker Mfg. Co.*, 192 F. 2d 270 (C.A. 4, 1951), cert. den. 343 U.S. 914, 96 L.Ed. 553, 72 S.Ct. 647; *Ritchie v. Lewis-Browning Mfg. Co.*, 196 F. 2d 434 (C.A. 5, 1952); *Continental Farm Equipment Co. v. Love Tractor*, 199 F. 2d 202 (C. A. 8, 1952).

In the case at bar both of the courts below recognized that the *A. & P.* case announced a more strict test of invention for combination patents than had existed theretofore but held that the Graham patent meets the test and

is not invalidated by the rule there laid down. In its letter opinion (R. 16-17) the Trial Court said:

> "*** Undoubtedly that decision *(A. & P.)* does tighten the validity tests for a combination patent. Of course it does not rule out such patents, however. In this present patent, as I see it, there is structural novelty in the fulcrum assembly and even greater merit in the reputed suitability of such structure for digging a scalloped pattern through the plowed earth. It is said that this manner of plowing serves to retain and conserve moisture accumulating at the bottom of the furrow. This obviously would be a distinct advantage in dry sections of the country and would be an achievement of real public interest and benefit. It is true that some of the prior art patents cited by the Defendants do deal with groundworking agricultural tools designed to have some vibration in operation, but so far as I have noticed none is described as having the design to do what is said to be done in the above respect by the Graham tool. It seems to me that these considerations save this patent from the condemnation of the last cited case. ***"

In other words the Trial Court found novelty in the fulcrum assembly (which novelty is spelled out more precisely in the court's letter to counsel dated April 12, 1952, Appendix "A" of this brief, p. 89) and a new result in the plow's alleged suitability for digging a scalloped pattern through the plowed earth.

The Court of Appeals approved generally the Trial Court's findings of novelty and the Trial Court's finding

of new result. (R. ——) The Court of Appeals does not say what new and useful result the Trial Court found but presumably it was referring to the Trial Court's letter opinion above set out where the Trial Court referred to the plowing of a scalloped pattern through the earth. That must be the finding to which the Court of Appeals refers because, while the Trial Court's findings of novelty are extensive and minute, there is no Trial Court finding of new and useful result or of invention except that mentioned in reference to the plowing of a scalloped pattern. Additionally, the Court of Appeals said (R. ——):

> "**** Independently of those findings, we think the evidence fairly establishes that the patentee, Graham, was the first to perfect the idea of resilient and frictional engagement of the shank of a ground-working tool between a fixed part and a movable part, or between the bracket on the H-beam and the fulcrum plate pivotally mounted on the bracket. His production of an efficient mounting for a ground-working tool shank that would permit it to rock or vibrate, and yet obviate the necessity of it being hinged directly on a fixed member, as in the Valley City Device and the prior art, was novel both in method of operation and result accomplished, and, we think, entitled him to a valid patent on the combination claimed. The Graham patent may not here be invalidated under the tests for invention laid down in the *A. & P. Tea Co.* case, *supra*, since that case involved only uniting old elements 'with no change in their respective functions', *whereas the patent here involved combines both old and new elements to produce a new result.*" (Italics ours.)

We respectfully submit that both of the courts below, having found novelty and usefulness, assumed without adequate consideration that invention also was present and in this respect have clearly erred. We believe that a careful examination of the record will reveal beyond any question that *there is no new element present in Graham, that there is no new result*, that the combination is simply a uniting of old elements without change in their respective functions, and that the changes, alterations and arrangements made by Graham, when considered in the light of the prior art and in the light of the particular problem, were nothing more than manufacturer's modifications well within the expected skill of one skilled in the agricultural implement manufacturing art.

Judge Chestnut remarked in *Ingersoll-Rand Co. v. Black & Decker Mfg. Co.*, 94 F. Supp. 938, 941 (D.C.D. MD. 1951), affirmed 192 F. 2d 270 (C.A. 4, 1951):

> "Despite the helpful guidance of this very recent opinion (*A. & P* case) there is still no precise legal yardstick to measure the requisite standard of invention, other than the considered judgment of the trial or appellate judge which, as was long ago pointed out by Judge Learned Hand in the second circuit, is necessarily to a large extent by reason of the subject matter, effected by the subjective point of view of the judge. Each case must, therefore, unless and until there is more precise congressional direction, remain to be decided on its particular facts. ***"

As this Honorable Court recognizes and as Judge Chestnut said, the true determination of whether there was or

was not invention lies in an analysis of the facts. What has the alleged inventor done? What was the state of the art at the time of his alleged invention? What was the particular problem facing him? Is there any new unusual or unexpected result? Does the combination change the respective functions of the parts and is the whole something more than the sum of the parts? Is the combined result something more than an exercise of the "know-how" expected of a person skilled in the calling? We respectfully submit that when the question of what the alleged inventor has done is answered in the light of the prior art it is clear beyond any question that no invention is disclosed.

From about 1937 to the Spring of 1946 both petitioners and respondents and their predecessors manufactured and sold substantially similar chisel plow of H or I-beam frame contruction with a plurality of curved spring steel shanks mounted to the lower flanges of the beams by means of rigid slidable clamps which firmly fixed the forward end of the shank in position. By reason of the inherent resiliency in the curved spring steel shanks the plow tools operated in a gouging or chiseling manner, hence the name "Chisel Plow". Such plows were widely received and used as valuable implements in moisture and soil conservation, and Graham claimed and advertised for many years that such plows (with the rigid clamps) were superior from the standpoint of moisture and soil conservation and economy of operation. (Finding of Fact

No. XII, R. 23.) When the Graham plows went into use in the rocky territory of the north and northwest in 1946 serious problems of breakage and bending immediately arose and the need for a flexible clamp mechanism of some sort for each separate shank of the plow became urgent. (Finding of Fact XIII, R. 23)

It becomes pertinent, therefore, to consider the state of the art at the time Graham encountered the problem. Some of that art is set out in Defendant's exhibit 139 (R. 1190-1264), and we call particular attention to the patents to *Dunbar*, No. 211,003 (R. 1191), *Carter*, No. 231,268 (R. 1194), *Rix*, No. 246,417 (R. 1197), *Rix*, No. 260,239 (R. 1200), *Moore*, No. 503,288 (R. 1205), *Lamprell & Cook*, No. 1,141,804 (R. 1212), Australian Patent No. 1056/26 to *Prior* (R. 1246), Australian Patent No. 111,910 to *Traeger* (R. 1249), *Cobb*, No. 284278 (R. 1253) and *LaDow*, No. 691,571 (R. 1265).

Before considering the prior art in detail two preliminary and incidental questions should be disposed of. We, of course, recognize the presumption of validity which attaches to a patent upon its issuance. That presumption is based in part upon the assumption that the Patent Office has duly considered the pertinent prior art, but:

> "Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dis-

> sipated." *Jacuzzi Bros. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 (C.A. 9, 1951).

Such is the case here. As revealed by the file wrapper, Defendant's exhibit 196-A (R. 1276-1331), and reference patents, Defendant's exhibit 196-B (R. 1332-1352), the prior art considered by the Patent Office was virtually nil and certainly was not the most pertinent prior art. None of the prior art patents shown in Defendant's exhibit 139 (R. 1190-1275), were cited by the Patent Office, and even a cursory scanning of those prior patents reveals that many of same are more pertinent than anything considered by the Patent Office. Under such a state of facts we do not believe that Graham's Patent can receive any support by reason of presumption as to its validity.

Apparently the Trial Court was inclined to look askance upon the prior patents cited by Petitioners because, insofar as the record shows, they were mere paper patents with no history of practical utility or commercial success, but we submit that the patents are entitled to more weighty consideration. In *Merit Mfg. Co. v. Hero Mfg. Co.*, 185 F. 2d 350, 352 (C.A. 2, 1950), Chief Justice Learned Hand said:

> "Perhaps it would be desirable that an inventor should not be charged with acquaintance with all that the patent offices of this and every other country contain, and with all that has ever been publicly sold or used in the United States: although in that event it would be an inevitable corollary that infringements

> should be limited to plagiarisms. With such considerations we have nothing to do; as the law stands, the inventor must accept the position of a mythically omniscient worker in his chosen field. As the arts proliferate with prodigious fecundity, his lot is an increasingly hard one."

And in *In re Coey*, 190 F. 2d 347, 351, (C.C.P.A. 1951), the court said:

> "Appellants' objection that the Elliott patent is 'a mere paper patent' cannot be recognized by this court. Everyone is charged with knowledge of the prior patent, and the failure of a patentee to properly exploit his invention does not furnish grounds for the subsequent granting of another patent on substantially the same invention. As stated by Judge Learned Hand in Western States Mach. Co. v. S. S. Hepworth Co., 2 Cir., 147 F. 2d 345, 350, 'A patent may have lain for years unheeded, as little a contribution to the sum of knowledge as though it had never existed, an idle gesture long since drifted into oblivion. Nevertheless, it will be as effective to invalidate a new patent, as though it had entered into the very life blood of the industry.'"

It is clear, therefore, that the prior patents introduced by Defendants must be given full consideration. *What, then, was the state of the art when Graham approached the problem?*

Generally speaking, the prior patents cited reveal a variety of spring mounting devices for the ground-working tool of agricultural implements to permit the ground-

working tool to ride up and over a rock or other obstruction and return to operating position. In all instances the ground-working tool is hinged or pivoted in some manner. In all instances the groundworking tool is held in its resilient position by means of spring pressure, the shape of the spring varying with the type of tool. In most instances the tool is pivoted about a pivot pin and in others about a pivot point. When coil springs are used the pressure of the coil spring is generally transmitted by means of a spring rod or rods. In some instances the tool is pivoted directly upon the pivot pin or point and in others it is pivoted indirectly by being attached to a pivotal, hinge or fulcrum member which in turn is pivoted upon the pivot pin or point. In some instances the fixed part or bracket of the mounting is of channel shape formation to provide lateral support for the tool during its radial movement therein.

As the Trial Court found (Finding of Fact XV, R. 24-25) all of the elements of the Graham structure are found in the prior patents, though they are not found in precisely the same combination or arrangement as Graham, nor are they all found in a single prior patent reference. In this respect the opinions of the Trial Court and of the Court of Appeals are in conflict because the Court of Appeals has found in Graham a new element, i.e. the fulcrum member. There cannot be any question that this finding of the Court of Appeals is erroneous. While the particular form, shape and arrangement of the fulcrum

member in Graham may be different from the fulcrum members in the prior patents *it certainly is not a new element.*

The *Dunbar* patent No. 211,003, dated 1878 (R. 1191), discloses an harrow tooth hingedly mounted on the beam of a frame. The brace plate B of the shackle or clamp is bolted to the beam. A hinge member or fulcrum member D is pivoted upon the brace plate by means of a pivot pin D_d. The ground-working tool or tooth F is bolted to the fulcrum member and a curved or C spring is employed to put the proper tension on the tooth, while allowing it to yield when striking stones or other obstructions. Of the Graham elements, this old patent of 1878 reveals a bracket or fixed member, a movable or fulcrum member, a pivot pin, and a curved spring mounted in such manner as to perform the spring function as the Graham coil spring, spring rod, washer and nut.

The *Carter* patent No. 231,268, dated 1880 (R. 1149), reveals another spring harrow tooth mounting. A metal bracket or fixed part E is mounted on a harrow beam A. A movable part, block, or fulcrum member G is pivoted by means of its pivots L in a socket J on the fixed member and is held resiliently in position by means of a coil spring C and spring rod D. The ground tool holder is mounted in a slot of the movable part G and is secured in position relative to the movable part by means of a bolt and nut. When any strain is brought to bear upon the

tooth the block turns upon its pivots sufficiently to allow the lower end of the tooth to clear the obstruction encountered, and as soon as the tooth is released from the pressure the spiral spring draws the block or movable part back into position again, thus causing the tooth to reassume its operating position in the ground. It is obvious that every single part of the Graham structure is present here except that there is no pivot pin in the strict sense and the fixed member is not of channel shape formation. The pivots on the movable part and the socket on the fixed part, of course, perform the function of a pivot pin.

The two *Rix* patents No. 246,417, dated 1881 and No. 260,239, dated 1882 (R. 1197 and 1200), reveal another spring mounted harrow tooth or cultivator shank. In each of these patents all the elements of Graham are present except for a separate movable part ~~of~~ or fulcrum member. There is a fixed part or bracket on the frame, a coil spring, a spring rod, nuts and washers to hold the spring and rod in position and a pivot pin about which the ground tool pivots. In these two instances the ground tool is pivoted directly on the pivot pin and there is no separate hinge member or fulcrum member. In both patents the function of the mounting is to provide a resilient or flexible tool mounting which will permit the tool under its spring pressure to clear rocks or other obstructions and return to operating position.

The *Cobb* patent No. 284,278, dated 1883 (R. 1253), is another spring mounted harrow tooth. A bracket or bail

A is attached to the harrow beam. A portion of the U shaped bail acts as the pivot pin or pivot point. A pivot or fulcrum member D is pivoted on the bail or bracket by means of the concave lower end thereof which forms a cradle bearing rather than a complete hinging eye or sleeve. The ground tool is inserted through a slot in the hook end of the fulcrum member and is attached to the fulcrum member by means of a nut and bolt. A curved C spring, very similar to that in the *Dumbar* patent, is attached at one end to the bracket and at one end to the fulcrum member to provide the necessary spring pressure to hold the tool resiliently in position and permit same to pass over obstructions and return to normal operating position. Of the Graham elements there are present here a fixed part and a movable part pivoted on the fixed part. There is no pivot pin present but the bottom of the U-shaped bail performs the same function. The circular spring as mounted, of course, performs the spring function of the coil spring, spring rod, washer and nut in the Graham structure.

The *Moore* patent No. 503,288, dated 1893 (R. 1205), reveals a spring mounting for a cultivator shank. A bracket member d, which is termed a yoke, is attached to a cultivator beam. A cultivator shank b is pivoted on the rear of the bracket or yoke by means of trunions e which are riveted to the shank by rivets f. A coil spring sleeved upon a spring rod is seated upon a depending portion or pocket of the forward part of the bracket to provide the

spring pressure for the spring action of the shank. The device is self-operating only within certain limits. When extreme forces are encountered the forward end of the shank will compress the spring so far as to permit the shank to ride clear of the washer. To return the tool to operating position it is necessary to raise the shovel out of the ground and permit the forward end of the shank to rise above the washer on the spring. The Graham elements present are a bracket, a coil spring, a spring rod, and nuts and washers. A pivot pin in the strict sense is not present but the trunions perform the same function. Also, there is not a separate fulcrum member. The trunions mounted upon each side of the shank are pivot members but the method of attachment to the shank is essentially the same thing as passing a pivot pin directly through the shank. Of course, in the particular Moore structure the trunions serve the purpose not only of pivoting the shank but also of providing its lateral support within the bracket or yoke.

The *Lamprell & Cook* patent No. 1,141,804, dated 1915 (R. 1212), reveals a spring mounting for a cultivator shank which needs little explanation. A bracket C is mounted on the cultivator beams. The cultivator shank a is pivoted on the bracket by means of a pivot pin b. A coil spring is mounted on a plate on the forward portion of the bracket and is held in position by means of a spring rod and nut and washer. The pressure of the spring is transmitted to the forward end of the shank by means of a

U-bolt bridle which is connected to a plate over the top of the spring and pivotally connected to the forward end of the shank. The method of operation is obvious. Every single element of Graham is present here except the separate movable part or fulcrum member, the shank here being pivoted directly.

The Australian patent to *Prior*, dated 1926 (R. 1248), is called a "stump jump mechanism for cultivating implements." A large channel shaped block or bracket 6 is attached to a square beam 5 by set screws 7. The forward end of the shank or tooth is pivoted on a pivot pin or bolt 9 at the lower forward corner of the block or bracket. A coil spring 16 has one end engaging the tooth or shank at a point rearwardly from the pivot pin and the other end seated on a washer 17 which in turn is seated upon a plate 19 affixed to the upper part of the bracket. A set screw 18 passes through the plate 19 and engages the washer 17 to adjust the tension of the spring. The method of operation is obvious and all the elements of Graham are present here except the spring rod and the separate fulcrum member. In the spring mounting here, of course, there is no need for the spring rod.

The Austrailian patent to *Traeger*, dated 1940 (R. 1249), is another spring tooth mounting. The manner of attachment to the beam of a plow is not revealed but it would, of course, be understood that the device would be mounted in some suitable fashion, either to a beam or to a bracket

fixed upon a beam. A movable part or hinge member 5 is pivoted upon the hinge pin 3, and the plow tooth or shank is attached to the hinge member by a rivet 6 at a point slightly forward of the pivot pin. The forward end of the shank extends farther forward and connects pivotally with the lower end of two spring rods 11 which extend upwardly through a plate 13. Coil springs 10, seated on the plate 13, are sleeved over the spring rods and are held in position by nuts 16 and washers 17. The method of operation is obvious. Every single element of the Graham structure is present here except that the method of attachment to a fixed part or to a beam is not revealed. The springs, spring rods, nuts and washers, the pivot pin and a separate hinge member or fulcrum member are all present.

The *LaDow* patent No. 691,571, dated 1902 (R. 1264), discloses an elastic joint or mounting for an harrow tooth. A channel shaped support or frame member C is arranged with its f anges extending to the rear. A tooth support or saddle member B is mounted upon the channel member C and pivoted thereon by means of a groove or socket arrangement. The harrow tooth A is mounted in the saddle and the entire device is resiliently clamped together by means of a circular spring D acting upon the tooth, the saddle and the beam. The circular spring here performs the function of the coil spring, the spring rod and the washer and nut in Graham. There is no pivot or fulcrum pin but rather a fulcrum point. There is a separate

fulcrum member or pivot member and *the entire device is clampingly held together solely by means of the spring pressure.*

To complete the prior art picture, the Valley City Device should again be noted. The Trial Court found that not only did that structure antedate Graham's final conception (Finding of Fact XIII, R. 23-24), but also the general description thereof was actually known to Graham when he instructed his employee Shelton to draw Defendant's exhibit 98 (R. 1172), which drawing is the earliest drawing of a spring clamp device exhibited by Graham (Finding of Fact X, R. 22). It is not necessary to resort to constructive notice to Graham of the Valley City Device for the Trial Court has found that he had actual notice, and the device therefore constitutes a pertinent part of the prior art.

The details of the Valley City structure have been pointed out above. Every single element of the Graham patent is present in that structure except that there is no separate fulcrum member. In that device the hinge or fulcrum member is welded directly to the shank.

The predominant function common to all of the prior art references is the obstruction clearance feature, i.e. the spring loaded hinging of a ground-working tool to hold the tool resiliently in operating position and to permit same to clear obstructions and return to operating position. Likewise, the prior art references disclose and

claim agricultural implements with a vibrating, pumping or trembling operation of the plow tool. Respondents expert, Mr. Fenton, said eleven of the prior patents in evidence claimed pumping action. (R. 995) And it would seem elementary from the very nature of the construction of such devices that there would be a pumping or vibrating action of the plow tools in operation, varying according to the inherent resiliency of the shanks, the strength of the springs used, and the magnitude of the forces encountered. The obvious result would be the digging of a more or less scalloped pattern through the earth depending upon the amount of the chiseling, vibrating or pumping action.

Before considering the question of what the alleged inventor did and whether it amounts to invention a correct rule for analysis must be determined, and we believe must be determined contrary to the view indicated by the Court of Appeals. The Court said (R. 136-7):

> "We think the basic fallacy of appellants' position as to the lack of invention in Graham lies in their attempt to show anticipation by separating the entire combination into its component elements and, in the light of hind sight, to expose them piecemeal as already known to the agricultural art. This form of attack on the validity of a patent received early disapproval by the Supreme Court in Parks vs. Booth, 102 U.S. 96, 104 ***"

We do not believe *Parks v. Booth* condemns absolutely the separating of a combination patent into its component

elements and exposing same in the light of the prior art, but if it does then it is contrary to the *A. & P.* decision. Certainly that method of analysis has long been used and approved. In *Lyman Gun Sight Corp. v. Redfield Gun Sight Corp.*, 87 F. 2d 26, 28 (C.A. 10, 1937), the court said:

> "Where a patent includes a combination of elements, it is not necessary to establish anticipation that all of the elements be found in a single earlier patent or in a single device previously in general use. It is enough if the evidence, taken as a whole, discloses that all of the claimed elements are found in different prior patents in the art or in different devices previously in general use, and no new functional relationship arises from their combination."

See also, *Electric Vacuum Cleaner Co. v. P. A. Geir Co.*, 118 F. 2d 221 (C.A. 6, 1941); *United Specialties Co. v. Industrial Wire Products Corp.*, 186 F. 2d 426 (C.A. 6, 1951); *General Bronze Corp. v. Cupples Products Corp.*, 189 F. 2d 154 (C.A. 8, 1951); *Leishman v. General Motors Corp.*, 191 F. 2d 522 (C.A. 9, 1951); *Hutchinson Mfg. Co. v. Mayrath*, 192 F. 2d 110 (C.A. 10, 1951), cer. den. 343 U.S. 914, 96 L.Ed. 553, 72 S.Ct. 647.

We come then to the analysis of what Graham has done and whether it amounts to invention. In answering these questions we recognize that we must not oversimplify by hind sight, we must attempt to view the problem as it came to Graham and evaluate his efforts in terms of the information then known or available.

Graham testified that he had given some thought to the spring mounting as early as 1940, had started to work on it seriously in 1945 and had the device completely worked out in his mind by the first of March, 1946. (R. 160-161, 979) There is no tangible evidence in the way of drawings, descriptions or models of his efforts prior to the drawing, Defendants' exhibit 98 (R. 1172), and the Trial Court found (Findings of Fact X, R. 22 and XIII, R. 23-24) that when Graham instructed his employee Shelton to make the drawing Defendants' exhibit 98 he knew generally the construction of the Valley City Device. Graham referred to the device as a *gadget* (R. 170), but the similarity of the Valley City *gadget* to Graham's first complete drawing, Defendants' exhibit 98, is remarkable. Comparing the Valley City drawings, made by the farm boy Elmer Helfeld (Defendants' exhibits 87-A through H, the originals of which are before the court), with the first Graham drawing, Defendants' exhibit 98, (R. 1172) it is apparent that the elements are virtually identical. In each instance there is a body part of the clamp or mounting which is attached to the lower flange of the H-beam or I-beam by means of set screws, the set screws being set in the under side of the clamp to work upward against the bottom face of the lower flange of the beam. In each instance there is an eye at the rear of the bracket or body portion of the clamp to receive a pivot pin. In Valley City the eyes are welded to the body and in exhibit 98 the eyes are made

an integral part of the casting of the body portion. In each instance there is a coil spring sleeved upon a spring rod and held in position by means of a washer and nut. In each instance the spring rod is composed of two parts, a long portion upon which the spring sleeves and a short portion which passes through the forward end of the shank. In each instance the two parts of the spring rod are linked together by means of eye-links in each of the parts to provide a swivel or pivotal connection to accomodate the downward movement of the forward end of the shank under tripping operation. In the Valley City Device the spring is, of course, seated upon a separate plate or strap iron attached to the upper flange of the H beam, whereas in Defendants' exhibit 98 the spring seat is a forward and upward projection from the main body portion of the clamp. Certainly, there is no difference of consequence in the two spring seats. The only structural difference of consequence between the two devices is that in Valley City the pivot portion or hinge member is welded directly to the shank, whereas in exhibit 98 the hinge member is attached to the shank by the short length of the I-bolt at the forward end which fastens the shank and hinge member together at that point. There is a further difference in that in Valley City as disclosed in the Helfeld drawings the pivot pin is above the shank whereas in exhibit 98 the pivot pin is below the shank.

Mr. Shelton recalled that the Valley City Device had the pivot pin located below the shank (R. 309), and that was

also Mr. Richter's testimony (R. 888). The model made by Mr. Richter during the trial, Plaintiff's exhibit 73 which is before the court, shows the pivot pin below the shank. If Mr. Shelton and Mr. Richter were correct in the placement of the pivot pin in the Valley City Device then there is no difference in that respect between the Valley City Device and Defendant's exhibit 98. It is intresting to note that the two subsequent variations of the Valley City Device as installed on the Holm plow, Defendant's exhibit 81-C (R. 1147), and the Ulmen plow, Defendant's exhibits 82-A (R. 1150) and 84-G (R. 1162), reveal the pivot pin in one instance below the shank and in the other instance above the shank. It hardly seems a matter of any consequence whether the pivot pin is located above or below the shank.

The next tangible evidence of Graham's development is the drawing, Defendant's exhibit 99 (R. 1173), which was the second drawing made by Mr. Shelton. (R. 307) Two principal differences from the exhibit 98 are apparent. The spring seat has been moved down from its upward projection and is simply a forward projection of the main body portion of the bracket. The eye-bolt has been replaced by a curved spring rod much in the manner of *Rix* (R. 1197 and 1200) or *Traeger* (R. 1252). With the moving down of the spring seat there obviously was no room for the eye-bolt swivel connection, and in the absence of a swivel connection to accommodate the arc of travel of the forward end of the shank in its tripping

movement it was necessary to provide an arc in the spring rod.

Graham's next effort is revealed by the drawing, Plaintiff's exhibit 44, dated April 3, 1946 (R. 1053). This drawing is obviously a dimensional drawing for production purposes. Two more principal changes appear here. The fulcrum member, which in the drawing is called a "radius arm," does not have a complete eye or sleeve bearing on the pivot pin but simply has a cradle or groove bearing. It is almost too elementary to mention that in the foundry casting of the fulcrum member it would be far simpler to cast a groove bearing rather than a sleeve bearing since the latter would require a core in the casting process. This elementary foundry problem was recognized by Mr. Cobb in designing his spring tooth harrow in 1883 (R. 1254, lines 26 through 29). The cradle bearing, of course, operates in the same manner as the sleeve bearing. The additional difference of consequence is that the forward end of the radius arm or fulcrum member has also been provided with a recess or groove to receive the head of the spring rod and provide the pivotal connection of the spring rod with the fulcrum member thereby eliminating the eye swivel as in Defendant's exhibit 98 or the curved rod as in Defendant's exhibit 99. The construction of the spring rod is not revealed by the drawing, Plaintiff's exhibit 44, for the obvious reason that the drawing was devoted to foundry problems in casting the body portion of the clamp and the movable por-

tion of the clamp, and the shape of the spring rod was not a foundry problem. The subsequent patent drawings reveal the shape of the spring rod as having a T-head to pivot in the groove of the forward end of the fulcrum member. One additional minor change is noted. Provision has been made for the set screw to be mounted upon the upper rear portion of the clamp to operate downwardly upon the upper surface of the lower rear flange of the eye beam to hold the clamp in position on the beam. This detail is noted in the side view drawing in the upper left hand corner of Plaintiff's exhibit 44. The positioning of the set screw to fix the clamp in position on the beam is a matter of no consequence here.

To complete Graham's development picture it should be noted that two rough shop models were made by Graham's employee McKee in April, 1946. The first of those models could not be produced at trial but Mr. McKee made a rough pencil sketch of the model during the trial which appears as Defendant's exhibit 100 (R. 1174). That model contained a box or sleeve pivot member in which the shank was inserted and held in position by means of set screws. It was rejected by Graham as being impractical (R. 383). The second model made by McKee is before the court as Plaintiff's exhibit 34. In that model the box-shaped fulcrum member or hinge member was eliminated and replaced by a plate hinge member. The further development by Graham prior to filing his application for

patent was in experimenting with various sizes of springs, and is of no particular consequence here.

We freely recognize that none of the prior art patents or devices reveal a structure that contains all of the precise elements of Graham. We further recognize that they do not reveal the particular positioning or arrangement of parts as shown in Graham. Finally, we recognize that the particular shape or form of the Graham parts are not revealed in the prior art. But we respectfully submit that every single element of Graham is present in the prior art and the question here is whether Graham has so combined those old elements as to amount to invention.

The crux of the matter is Graham's method of mounting the shank. His shank is mounted between the lower face of the bracket member and the upper face of the fulcrum member and resiliently held in position by means of the spring pressure. The shank is not firmly or rigidly attached to the hinge member but is held in the mounting by means of the spring rod which acts both as the means for transmitting the spring pressure and also as the means for holding the shank in the device, or otherwise put, for carrying the pulling load of the shank. The load carrying function of the spring rod necessitates a series of elongated openings in the bracket member, the shank and the hinge member to eliminate binding or shearing of the spring rod during the tripping operation. The result of this arrangement is a longitudinal sliding motion of

the shank relative to the hinge member and the bracket during operation.

In most of the prior art structures the shank is pivoted directly on a pivot pin by penetration of the shank or by attachment of the shank firmly to a hinge member which in turn is penetrated by the pivot pin, whereas in Graham the shank is loosely attached to the hinge member by means of the loose connection at the forward end with the spring rod. In actuality, as the witnesses pointed out (R. 118, 155, 317-318), the Graham shank does pivot directly on a point on the lower rear face of the bracket member where the shank emerges from the device, and the Fifth Circuit was clearly wrong in finding that the shank does not pivot directly on the fixed member.

In *Dunbar* the shank is attached to the hinge member by bolts and nuts. In *Carter* the shank is attached to the hinge member by a bolt and nut. In *Moore* the shank is attached to the hinge member or trunions by rivets. In *Traeger* the shank is attached to the hinge member by a rivet. In *LaDow* the shank is attached to the hinge member by the gripping or clamping force of the circular spring. In *Graham* the shank is attached to the hinge member by the spring rod. Graham's method of attachment is different but when his particular problem is isolated it is clear that no invention was involved.

Graham's old chisel plow with the rigid clamp and resilient shank had proved to be very successful. As is

pointed out in the patent it was desired to retain the resiliency of the shank as a desirable feature of the plow. Graham recognized that welding the hinge member to the shank as in Valley City was undesirable, because it is difficult to obtain a good weld on spring steel, because such welding might tend to weaken the shank, and because such welding would be cumbersome from the production standpoint. He further recognized that penetrating the shank with a pivot pin was not practical because of both strength and manufacturing problems. He also recognized that reinforcing the shank at the pivot point was not practical from a manufacturing standpoint. His problem was to retain the desirable characteristics of the resilient spring steel shank and to hinge same in such manner as to avoid modification of the shank and consequent redesign of the whole plow. This was done by providing a separate hinge or fulcrum member. He attached the shank to the fulcrum member in a manner different from the prior art in that he used one means, the spring rod, to perform both the function of attaching the shank to the hinge member and the function of transmitting the spring pressure, whereas in most instances in the prior art the shank was attached to the fulcrum member by a separate means, nuts and bolts, rivets, or welding. The rule is too elementary to require citation that doing by one means what has formerly been done by two means does not amount to invention unless there is a new function or a new result attained, and it is clear beyond any

question that Graham's arrangement providing for the spring rod to carry the spring pressure and to attach the shank to the mounting does not produce any new function or new result. We still have simply the transmitting of spring pressure by means of a spring rod and the attachment of the shank to the hinge member by means of a rod or bolt. The two functions of transmitting the spring pressure and of attaching the shank to the fulcrum member are still two separate functions simply performed by one element. The resulting sliding longitudinal movement of the shank relative to the hinge member is somewhat different from anything shown in the prior art, but it is the inherent result of the spring rod performing the dual function. There is nothing unusual or surprising about it.

The patent lays great stress on the so-called clamping or gripping function of the lower face of the bracket and the upper face of the fulcrum member on the shank, and the Fifth Circuit has found (R. 1363-1364) that this resilient and frictional engagement of the shank is a new function, a new method of operation and attains a new result entitling Graham to his patent. Obviously the face of the bracket and the face of the fulcrum member can perform no gripping or clamping function without the aid of the spring and spring rod. *The sole force for clamping the shank is that provided by the spring.* The purpose of the spring in all the prior art references is to hold the shank of the ground-working tool resiliently in position, and whether the force of that spring is transmitted directly

to the shank itself or indirectly by acting through the fulcrum member seems to us inconsequential. The result in either instance is precisely the same, i.e. the resilient retaining of the shank in position.

But Respondents assert that while the springs in the prior art have resiliently held shanks in position they have not done so by clamping a shank between the lower face of a fixed member and the upper face of a fulcrum member - they have not acted in a clamping or gripping manner. The Fifth Circuit agreed with that contention but we respectfully submit that *the essence of this idea was completely contained in the LaDow patent* (R. 1264-1275). Referring specifically to figure 11 (R. 1266) it is obvious that the beam or bracket, the fulcrum member or saddle and the shank are not fixed rigidly in position relative to each other by any kind of fastening but are loosely mounted and are held in their positions relative to each other *solely by means of the spring pressure* which is exerted on one side against the beam or bracket and on the other side against the tooth, with the fulcrum member or saddle being held in its position by the opposing forces of the spring on the beam and tooth. Admittedly, in *LaDow* the shank is not mounted between the bracket member and the hinge member, but is it a matter of any consequence to interchange the position of the parts? Would the result be any different if the tooth were pivoted directly on the frame member or bracket as in Graham and the fulcrum member placed on the opposite side so that

the spring pressure would be transmitted first to the fulcrum member and then to the shank. Such a reversal of position does not alter the method of operation, the function or the result one iota. *LaDow* does not *look like* Graham but looks do not control.

We respectfully submit that both the Trial Court and the Court of Appeals have clearly erred in failing to give adequate consideration to the prior art, in failing to recognize that all of the elements of Graham are present in the prior art, that the functions of the individual elements are present in the prior art and that Graham's combination of these old elements is simply a bringing together of the old elements in such a unit that they still perform their individual functions without more. As the witness Trautmann picturesquely stated in comparing the Graham commercial structure with the Valley City Device, "it was the same thing, just put in a mold." (R. 265, 302) Surely the kind of modifications made by Graham do not rise to the dignity of invention. They are the kind of steps that are being taken daily by skilled mechanics and engineers in manufacturing plants all over the world. The Valley City Device was a crude handmade implement made in the field at the moment when the need arose, not designed or intended at the moment to be a commercial structure but rather to immediately solve the rock problem that was urgent. It cannot be cast aside because it was not a nicely tooled commercial structure. The additional modifications made by Graham were noth-

ing more than manufacturer's refinements well within the expected skill of an implement manufacturer.

The Court of Appeals found a new result (R. 1364) without stating what that new result is. Apparently it was referring to the Trial Court's reference to the "reputed suitability of such structure for digging a scalloped pattern through the plowed earth" (R. 16) with its accompanying use and benefit in the conservation of moisture. Respondent's expert, Mr. Fenton, pointed out (R. 995) that eleven of the prior patents cited by Petitioners claimed vibrating or pumping action. It is obvious that the scalloped pattern through the earth as mentioned in the patent and as referred to by the Trial Court is nothing more than the result of the vibratory or pumping action of the plow tooth as it travels through the ground. That pumping action is the inherent result of the resiliency of the curved spring steel shank and the spring mounting of the shank. Its degree and continuity of necessity depends upon the resiliency of the shank, the strength of the springs used and the magnitude of the forces encountered in the soil. That result is not new with Graham; it was pointed out in the prior patents and is inherent in the structure, *not only in the Graham structure but in all of the structures mounting a shank in a resilient spring manner.* The only new result in Graham is the equipping of the Graham type plow with a spring mounting for the shank. That is not the kind of new result that will sus-

tain invention. It is a new result like the equipping of an ordinary grocery counter with a sliding rack on guide rails as in the *A. & P.* case.

We have labored the question overly long but we believe it would be worthwhile to note two decisions handed down since the *A. & P.* case.

In *Hutchinson Mfg. Co. v. Mayrath*, 192 F. 2d 110, (C. A. 10, 1951), cert. den. 343 U.S. 914, 96 L.Ed. 553, 72 S.Ct. 647, the patent covered a portable grain loader. Considering typical claim 6 and claim 10, the court said at p. 111:

> "The elements of Claim 6 are: (1) A screw conveyor and its housing tube; (2) A wheeled frame having a vertical post; (3) A sleeve pivotally secured to the housing tube and slidably mounted on the post; (4) A motor supporting frame on the sleeve; (5) A motor unit on the motor supporting frame slidably mounted thereon and operably connected with the screw, such connection including a belt and pulley drive and idler wheels positioned tangentially of the pitch circles of the drive and driven pulleys.
>
> "The elements of Claim 10 are: (1) A wheeled frame having a vertical post; (2) A sleeve slidably encompassing said post for vertical movement therealong; (3) a stub axle extending laterally from such sleeve; (4) A feed screw housing pivoted on said axle (5) A feed screw in said housing, and (6) A motor mount secured to said sleeve and extending laterally therefrom in a direction opposite to that of said axle, such motor mount comprising a pair of spaced arms, a

pair of parallel guide rods extending between said arms, and motor mounting elements slidably engaging said guide rods."

After finding that all of the elements were disclosed in the prior art, *though not in a single prior patent disclosure*, the court in holding the patents invalid said at page 113:

"We are of the opinion that the respective individual functions of well known elements drawn from prior art patents are not changed or increased when assembled in the device of the patent in suit, and that they produce no result other than the aggregate results of such functions. They are not so united that by their reciprocal influence upon each other or their joint action on a common objective they perform additional functions and accomplish additional results. In other words, they do not meet the test laid down in Great A & P Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 151, 152, 71 S. Ct. 127, 95 L. Ed. 162, that the whole in some way must exceed the sum of its parts.

"Although all the elements are not found in one patent and therefore no single patent anticipates, if such elements are found in different prior patents in the same art, such disclosures may be properly considered on the question of whether invention or mechanical skill was involved.

"And where a patentee brings together old elements in a mechanism, involving no new principle, to produce an old result, although he produces a machine that is more efficient and hence more useful in the

art, it is still the product of mechanical skill and not of invention.

"Here, we think the bringing together of old and well known elements disclosed in the prior art patents did not rise to the dignity of invention, but rather involved mere mechanical skill."

In *Continental Farm Equipment Co. v. Love Tractor*, 199 F. 2d 202 (C.A. 8, 1952), plaintiff's patent covered a disc type plow or harrow with three functions, (1) adjustability, means for permitting the gangs of discs to be moved backward or forward, (2) floatability, means for permitting the gangs of discs to move up or down to follow the contour of the land, and (3) liftability, means for permitting the gangs of discs to be lifted free from the ground for mobility. Adjustability and floatability had been provided in the older disc plows. Liftability had been provided in other types of plows and rigid implements. The patentee combined all three functions in his disc plow. The court recognized that the combining of these three results had not been done with a disc plow before and that useful results were provided thereby, but said at page 205:

"We agree with the trial court that the mere fact that all the elements of the machine are old does not prevent their combination from becoming a patentable device; that commercial success, novelty, utility, imitation by those skilled in the art, and the practical satisfaction of a need long recognized, are some indication of the inventive thought required to produce the device; and that sometimes, viewed after the

> event, the means adopted seem simple. But we are unable to find anything that had to be done or that was done in combining the three principles of liftability, flexibility, and floatability which was the result of the application of more than mere mechanical ability. Hence, we fail to find adequate evidentiary support for the trial court's finding of invention. The validity of the patent cannot be sustained under those circumstances."

The case at bar is precisely on all fours in principle with the *Mayrath* case and the *Love Tractor* case. The results should be the same.

We earnestly urge that the Patent Office has fallen into the habit of considering a patent application from the point of view of novelty and usefulness with little regard to the question of invention. If novelty and usefulness are found the patent is issued and the question of invention is left for determination by the courts in the event the patent is challenged.

In the case at bar the Trial Court and the Court of Appeals have satisfied themselves with a process like that of the Patent Office. They have satisfied themselves with findings of novelty and usefulness and have failed to give adequate consideration to the question of invention. They have sustained another patent which does not add to the total stock of human knowledge but rather withdraws into the web of monopoly matter that was previously known and available to skilled workmen.

In summary we respectfully urge that the courts below have failed to give adequate consideration to the prior art, have failed to adequately analyze the patent in terms of its constituent elements, have found new elements which do not exist and new results that are clearly old. They have failed to apply with sufficient strictness the rule laid down by this court in the *A. & P.* case and have sustained the validity of a patent which simply combines old elements without any change in their respective functions, with no new, unusual or surprising result and with no result that is more than the sum of the parts. Graham Patent No. 2,493,811 is void for lack of invention and the decisions of the courts below should be reversed and the patent declared invalid.

POINT B - INFRINGEMENT

Defendants' devices as exemplified by Plaintiffs' exhibits 6, 7 and 37 do not infringe any of the claims of the Graham patent for two reasons: (1) A proper interpretation of the Graham claims calls for a structure which will under all conditions of operation result in a constant and continuous pumping action of the ground-working tool produced in part by the vertical movement of the spring clamp mechanism; and (2) one or more of the elements in each of the Graham claims is not satisfied by the Jeoffroy structure.

1. Function (Pumping Action)

The patent (R. 1027-30) is replete with references to the pumping action and such pumping action is stated as a primary object of the patent. In Column 1, line 31, the patentee says:

> "Therefore, it is a principle object of the present invention to provide a plow of this character with tool mountings that result in maximum pumping action of the ground working tools."

In column 3, line 29, we find this langauge:

> "In order to accomplish the objects of the present invention the ground working devices 32 are carried upon the beams by novel mountings, arranged to give the tools the above described vibratory or pumping action."

In column 5, line 69 this appears:

> "When the soil breaks over the ground working tool, the spring is again effective to exert a lifting thrust on the forward ends of the shank 33, which causes the tool carrying end of the shanks to rock downwardly and produce downward and forward cut (a) in the soil until the resistance is again sufficient to cause the upward movement against the action of the spring 66, which movements produce a *constant rocking or pumping action of the tools to form a continuous series of pockets (b) in which moisture is adapted to collect.*" (Italics ours.)

Claim 1, column 6, line 44, says:

> "Means for attaching the shank to the frame which results in pumping action of the ground working device when the plow is in use,"

Claim 2, column 6, line 69, calls for:

> "Means for attaching the shank to the frame which results in pumping action of the ground working device in the frame when the plow is in use,"

Claim 4, after describing the structure, column 7 beginning in line 56 says:

> "for retaining the tool in the ground and yielding in response to resistance on said tool when the plow is in operation to produce a pumping action of the tool in the soil."

Claim 5, column 7, line 60 provides:

> "In a plow having a frame and a ground working tool provided with a shank adapted to rock relatively to the frame when the plow is in operation."

That same language of claim 5 is carried forward in claims 6, 7, and 8.

Plaintiffs' expert Fenton testified that the patent disclosed a structure providing for pumping action of the shank so that it may vibrate in the soil (R. 187). There could be no possible question of that as to claims 1, 2 and 4 - it is there spelled out in express language. In claims 5, 6, 7 and 8 the term used is "rock" rather than "pump", but Mr. Fenton said those claims also were di-

rected to a structure for producing a pumping action, though it is somewhat less clear in claims 7 and 8 (R. 233-34). When recalled as a rebuttal witness (R. 994-95) he hedged by saying that pumping action was not an essential part of the patent, that the claims cover a structure which in normal operation does result in pumping action of the ground working tool, but that such action was not essential to the patent.

The patentee Graham testified:

"The shank, it has a pumping action, more so than it would have without the spring." (R. 104)

"Q. Now you have spoken of this pumping. Will you explain just what you mean by pumping and just what takes place?

"A. Well, it is a resilient action, works all the time. The shank works all the time. The shank - different soil, hard spots, soft spots. It has a tendency to pump - it does pump.

"Q. In other words, the spring is compressed and expanding all the time; and the shank is pivoting all the time while the plow is in operation; is that right?

"A. Yes. That is, if it had any load on it at all." (R. 122)

"Q. Mr. Graham, do you get a vibrating action in the plows which you made and sold before either of the patents in suit?

"A. We do in the shank.

"Q. And because of that flexability you call them vibrating or chisel plows; is that right?

"A. That is in the shank. The clamp is tight, solid, but the shank has a certain amount of spring.

"Q. And that gives a vibrating action as the plow is pulled through the ground?

"A. It doesn't give as much vibrating action - we call it 'resilient.' It shakes.

"Q. Well, do you consider this pumping action then of the second patent in suit to be important?

"A. Yes." (R. 127)

Considering the express words of the patent in the description and in the claims, considering the testimony of plaintiffs' expert, and considering the construction placed upon the claims by the patentee himself, we believe the conclusion is imperative that the patent claims are directed to a structure which will produce a pumping action of the ground-working tool of a more or less constant or continuous nature under all conditions of operation, this pumping action being not merely the chiseling action provided by the inherent resiliency of the spring steel shank but a somewhat different action produced by the vertical fluctuations or oscillations of the tripping mechanism.

We readily recognize and admit without hesitation that a pumping action of the ground-working tool is a function that is the inherent result of a structure such as that

revealed by the Graham patent. It is also the inherent result of most of the spring mountings revealed in the prior art. The degree of such pumping or vibrating action depends upon the resiliency of the curved spring steel shanks, the strength of the coil springs used and the varying hardness of the soil encountered. At any time when the forces on the ground tool are sufficiently great to actuate the spring steel shank and the coil springs the pumping action will result. Its degree and continuity will depend upon the variations in the forces encountered. We readily recognize also that if the forces encountered are sufficiently great to actuate the great strength of the Jeoffroy springs the result will be a pumping action of the Jeoffroy structure. But the patent calls for a structure which will operate with the pumping action constantly and continuously under all conditions of operation, and certainly under normal conditions of operation.

The first rule of infringement is that the accused structure must perform the function of the patent structure or there is no infringement. If the accused structure does not function as provided for by the patent there is no infringement even though the identical elements are used. Therefore, if the Jeoffroy structure does not function with the constant and continuous pumping action as called for in the patent there is no infringement.

Defendants' expert Fishleigh construed the patent and all claims thereof as teaching a structure which would

result in a more or less constant or continuous pumping action under all conditions of operation, that being declared as a primary object of the patent and being the functional words used in the claims. With this interpretation of the patent he steadfastly maintained that while the defendants accused devices were capable of opening and closing when the load was sufficient to overcome the strength of the two heavy springs, they did not pump in accordance with the teaching of the patent, and for that reason, if for no other, they did not infringe. (Defendants' charts exhibits 214-219)

The defendant, Ray Jeoffroy, testified that the vibrating action inherent in the resilient spring shank was desirable and that it was defendants' design and intention by its spring trip to provide a solidly mounted shank which would retain all of the inherent resiliency thereof but which would open or trip to permit the clearance of rocks and other obstructions and then return the plow tool to its proper working position (R. 489-90, 506). And see the quote from Jeoffroy circular read by Mr. Fishburn (R. 517). It was his testimony that a proper working position for the plow point was approximately three degrees below the horizontal and that as the plow point moved away from that angle the pulling draft was increased, unnecessary and undesirable drag occurred, and the plowing depth would not be uniform (R. 489-90). He testified that when he first observed a Graham commercial trip in action in North Dakota it was apparent that the

springs were too weak and the trip was operating in an open position most of the time, which was extremely undesirable and was not answering the problem of the rocks. It was his opinion that the spring trip decreased the action of the plow tooth because it acts as a shock absorber or cushion taking away part of the inherent elasticity of the spring steel shank (R. 519-522).

On the other side, the plaintiff Graham testified that the Jeoffroy devices would pump just exactly like the Graham device, and plaintiffs' expert Fenton agreed with this testimony, though he admitted that his comparative observation of the two devices was gathered from very limited tests made with a plow, first, on which there was only one Graham mechanism and one Jeoffroy mechanism mounted (R. 229), and second, of a plow on which there was only one Jeoffroy mechanism mounted and the entire weight of that plow was riding on that one shank, in addition, at times there were one or two men standing on the frame of the plow as it operated to observe the action of the Jeoffroy mechanism, and the shank was of a size which needed a higher plow than they were using (R. 1003-04).

The testimony from the two sides was in serious conflict and upon the initiative of respective counsel for plaintiffs and defendants, the court observed field tests near the close of the trial. The courts' findings from his observation of such tests appear as Finding of Fact XVII (R.

25-26). For the tests a plow was used which normally carries a battery of eight to ten shanks. Only two shanks were mounted, one carried by a Jeoffroy clamp and one carried by a Graham clamp; consequently, the tests were not on a parity with ordinary field use and operation. The plow with the two shanks mounted was demonstrated first in plowed ground with the plow tools set five or six inches deep, and second in plowed ground with the plow tool set about eight inches deep. In the first test obvious pumping action was present with the Graham clamp and none with the Jeoffroy clamp. This plowing depth of approximately six inches, according to plaintiffs' expert Mr. Fenton is about normal plowing depth (R. 996, 998). In the second test at eight inches deep there was some pumping action present in Jeoffroy and much more present in Graham. In the tests in unplowed ground (native grass sod) strong pumping action occurred in Graham and only moderate pumping action with Jeoffroy. The court was unable to observe a plow equipped with a full normal set of shanks because the tractor did not have enough power to pull it.

The Trial Court in its Finding of Fact XVII (R. 25-26) recognized that the field tests observed were not on a parity with ordinary field conditions, but apparently failed to take that into consideration in reaching the conclusion that the Jeoffroy structure performed in substantially the same manner as called for in the patent. Mr. Ray Jeoffroy testified that the conditions of the field

tests observed by the Trial Court did not even approach normal operating conditions because the shanks were overloaded about 10 to 1. (R. 1016) *This testimony was not disputed.* It seems to us that the very small amount of pumping action present in the Jeoffroy structure with a shank overloaded to that extent unquestionably bears out the Defendants' position that its structure is designed and intended to open only when severe loads are encountered and that it does open and close only under such conditions.

The Trial Court in its finding of fact and in its letter opinion correctly recognized that the differences in pumping action are largely a matter of variations in spring strength. Nevertheless, the patent calls for, and the patentee construes it as calling for, a device which will pump under all condtions of normal operation. *The Jeoffroy structure does not so operate.*

We believe there is square authority for the proposition that under such circumstances the accused device does not infringe.

In *Pratt v. United States*, 43 F. Sup. 461 (Ct. of Claims, 1942), cert. den. 302 U.S. 750, 82 L.Ed. 580, 58 S.Ct. 270, plaintiff's patent was for a landing hook and gear device for aircraft, designed to engage an arresting gear on the flight deck of an aircraft carrier while the aircraft was still in flight, and to bring the aircraft to a stop in a relatively short distance. The accused device of

the United States Navy was a substantially similar device, but designed to engage the arresting gear after the wheels of the aircraft had touched the deck . The evidence was very clear that the structure of the two devices was substantially the same, involving primarily a landing hook pivotally mounted to the fuselage of an aircraft, designed to drop and extend below and to the rear of the aircraft at an oblique angle, with the hook designed to engage an arresting gear cable on the deck. In holding that the accused device of the United States Navy did not infringe, the Court of Claims said at page 475, et seq.

> "Here the proof shows that the supposed merit of plaintiff's invention, i.e., the slowing down of a plane while it is still in the air, in order to land it, has not been well regarded by the defendant and plaintiff has not shown that it had been adopted by others. The proof shows rather, as is brought out in our discussion of infringement, that so far as the defendant is concerned, the hook does not, if the landing is skillfully accomplished, engage the cable until after the plane has touched the deck, and if it does so engage it while the plane is a few inches off the deck just before touching it the cable exerts no retarding force until after the wheels of the plane are rolling on the deck. * * *
>
> "The purpose of the mechanism (defendant's) was not to retard planes while in flight and thus cause them to descent to the landing deck, but to retard their forward progress after they had touched the deck. The construction of the mechanism was such as to reduce to a minimum the possibility of the plane being caught and retarded in flight, which was regarded by the defendant as dangerous.

"The cables were placed so low that in every case if the plane had not already touched the deck when the hook engaged, it would descend only a few inches farther before doing so, and the tension of the cables was such that no retarding force would be applied to the plane until after its wheels were rolling on the deck.

"When plaintiff in 1921 made his demonstration to the defendant's officers, Commander (then Lieutenant) Stone disapproved plaintiff's idea of hooking a plane while in flight, saying it was dangerous. The proof shows that the defendant's officers never changed their views in this regard.

"It may be urged that even if the defendant did not desire to retard its planes while still in flight, and did not use its mechanism to do so except by inadvertence or unskillfulness, yet the mechanism was an infringement because it was capable of so operating, and did, on occasion, so operate. We do not think that the monopoly of a patent covers another device, constructed in good faith to operate upon a principle different from that involved in and intended by the patent, merely because it is impossible or impracticable to construct the other device so that it can be operated without inadvertently or unskillfully, upon occasion, infringing upon the outside boundaries of what might seem literally to be within the patent. The purpose and the real or supposed advantages of the patent have a bearing upon the scope of the monopoly. If the accused infringer does not recognize as an advantage the idea of the patent, avoids the use of the idea to the greatest extent possible, and does not in fact gain any advantage from his occasional straying across the supposed boundary, he is not, in fact, an infringer be-

cause the proper boundary of the patent does not extend so far.

"In the instant case, it would not be a proper application of the purpose of the patent laws to construe plaintiff's assumed patent for a device to retard the speed of a plane while still in flight so broadly as to prevent the development and use by others of a device to stop the roll of a plane after it has touched the landing surface. The two ideas are different. Indeed, plaintiff's asserted novelty lay only in the accomplishment of the former, since the latter was plainly anticipated. But because the whole problem arises out of the necessity for landing planes on a surface of limited area, and because the accomplishment of the feat is at best a hazardous one involving great skill, the defendant, desiring to retard the speed of the plane after it has touched the surface, should not be compelled, in order to avoid infringment, to waste a considerable amount of the limited landing area by locating its transverse cables so far forward on the deck that its planes will never engage one of the cables until after they have touched the landing surface."

The plaintiffs here, just as did the plaintiff in the *Pratt* case, assert that while Defendants' accused device do not pump under all conditions of operation yet they are capable of doing so under some conditions of operation and therefore constitute an infringement. That contention was struck down in the *Pratt* case and it should be struck down here. *"The purpose and the real or supposed advantages of the patent have a bearing upon the scope of the monopoly."*

We respectfully submit that the fundamental rule that a structure accused of infringement must perform the same function as that called for in the patent is not met. *Rowell v. Lindsay*, 113 U.S. 215, 28 L.Ed. 907 (1884); *Weatherhead v. Coupe*, 147 U.S. 322, 37 L.Ed. 188 (1893); *Electric Protection Co. v. American Bank Protection Co.*, 184 Fed. 916 (C.A. 8, 1911); *Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co.*, 194 Fed. 2d 945 (C.A. 7, 1952). See also, *Walker on Patents* (Deller's Edition, 1937), Vol. 3, §§ 466 and 467, and the numerous cases there cited. If the pumping action of the Graham structure is such a new result as to entitle Graham to a patent, then it is a function which becomes a limitation upon the scope of the claims, and a device which does not perform that function does not infringe.

2. Absence of Elements

As we have pointed out in the Statement Of The Case the mechanical elements or parts of the Graham structure are (1) a bracket or fixed member, (2) a pivot pin, (3) a fulcrum member hinged on the pivot pin, (4) a spring rod or bolt, (5) a coil spring, and (6) a washer and nut, and (7) a shank. We admit without hesitation that all of those mechanical elements or parts are present in the Jeoffroy structure, *but the inquiry does not stop there.* In the Graham claims those mechanical elements or parts are combined in a particular manner to perform partic-

ular functions. If that combination of elements is adequate to support validity of the patent, then those elements as combined by Graham and as specified in the claims become the limitations which determine the scope of the patent and the proper range of equivalents and infringement.

Perhaps no rule in patent law is better settled than the rule that a combination patent covers the combination only and not the individual elements therof, and that the absence of a single element or its equivalent in an accused device avoids infringement. *Rowell v. Lindsay*, 113 U.S. 215, 28 L.Ed. 907 (1884); *Dunbar v. Meyers*, 94 U.S. 187, 24 L.Ed. 34 (1876); *Weatherhead v. Coupe*, 147 U.S. 322, 37 L.Ed. 188 (1893); *Black Diamond Coal Mining Co. v. Excelsior Coal Co.*, 156 U.S. 611, 39 L.Ed. 553 (1895); *Electric Protection Co. v. American Bank Protection*, 184 F. 916, (C.A. 8, 1911); *McKays Co. v. Penn Electric Switch Co.*, 60 F. 2d 762 (C.A. 8, 1932); *Valjean v. Perfection Stove Co.*, 103 F. 2d 60 (C.A. 6, 1939); *Jogger Mfg. Corp. v. Roquemore*, 118 F. 2d 867 (C.A. 7, 1941), cert. den. 314 U.S. 629, 86 L.Ed. 505; *Dry Hand Mop Co. v. Squeez-ezy Mop Co.*, 17 F. 2d 465 (C.A. 5, 1927); *Texas Rubber & Specialty Corp. v. D & M Machine Works*, 81 F. 2d 206 (C.A. 5, 1936); *Getty v. Kinzbach Tool Co.*, 119 F. 2d 249 (C.A. 5, 1941), cert. den. 314 U.S. 651, 86 L.Ed. 522; *Stewart-Warner Corp. v. Lone Star Gas Co.*, 195 F. 2d 645 (C.A. 5, 1952).

Much has been written upon the problem of the range of equivalents to be accorded a patent, the general statement of the rule being that a pioneer patent is entitled to a broad and liberal construction and a wide range of equivalents where as a secondary or limited patent is entitled to a limited construction and limited or narrow range of equivalents. *Blanc v. Curtis*, 119 F. 2d 395 (C.A. 6, 1941); *Flowers v. Austin-Western Co.*, 149 F. 2d 955 (C.A. 7, 1945); *General Bronze Corp. v. Cupples Products Corp.*, 189 F. 2d 154 (C.A. 8, 1951); *Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co.*, 194 F. 2d 945 (C.A. 7, 1952); *Dow Chemical Co. v. Skinner*, 197 F. 2d 807 (C.A. 6, 1952); *Specialty Equip. & Machine Corp. v. Zell Motor Car Co.*, 193 F. 2d 195 (C.A. 5, 1952); *Stewart-Warner Corp. v. Lone Star Gas Co.*, 195 F. 2d 645 (C.A. 5, 1952); and the cases last cited above. One writer has concluded that a proper statement of the rule is that while a pioneer patent is to be accorded a broad range of equivalents and a limited or secondary patent is to be accorded a limited range of equivalents, yet in any case the patentee is entitled to a range of equivalents commensurate with the scope of his invention. *Walker on Patents* (Deller's Edition, 1937) Vol. 3, § 472, citing *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 52 L.Ed. 1112 (1908). But regardless of the statement of the rule, *it is clear in the case at bar that the Graham patent is a secondary patent in a limited and crowded art; that the invention, if any, is of a very*

limited nature, and is entitled only to a limited range of equivalents.

Mere statement of rules, we believe, little aids the inquiry, and a specific observation of cases will better delimit the problem. Two cases will suffice.

In *Rowell v. Lindsay*, 113 U.S. 215, 28 L.Ed. 907 (1884), plaintiff's patent covered an improved cultivator providing for a slotted beam, a plow shank riveted to the beam, a curved brace on the shank extending upwardly and rearwardly through the slot of the beam, and a bolt through the slotted beam for gripping the brace, holding the plow point in position under normal operation, yet yieldable to unusual forces to prevent breakage. The patent described the invention as follows:

> "This invention consists in applying to the shank of the tooth a curved brace bar, the upper end of which passes through a slot or mortise in the beam and is held in position by a clamping bolt, which passes transversely through the slot or mortise near the brace bar and forces the sides of the beam together against the brace bar, so as to clamp it in any required position, and thereby adjust the tooth in any inclination, at the same time allowing it to yield to immovable obstacles without breaking."

The claim was:

> "The combination of the slotted beam A, shank B, brace C, and bolt D, when the parts are constructed and arranged to operate as and for the purposes herein specified."

Defendant's accused device used a curved shank curving upwardly and rearwardly from the plow tooth to pass through a slotted beam. After finding that there was a great variety of shanks and standards for plows in the art, the court said:

> "The patent of the plaintiffs, therefore, stands on narrow ground and, to sustain it, it must be so construed as to confine it substantially to the form described in the specification.
>
> "The patent of the plaintiffs is for a combination only. None of the separate elements of which the combination is composed are claimed as the invention of the patentee, therefore none of them standing alone are included in the monopoly of the patent. ***
>
> "The patent being for a combination, there can be no infringement unless the combination is infringed. ***
>
> "But this rule is subject to the qualification, that a combination may be infringed when some of the elements are employed and for the others mechanical equivalents are used which were known to be such at the time when the patent was granted. ***
>
> "In the light of these principles we are to inquire whether the defendants use the combination described in the patent of the plaintiffs. The contention of the defendants is that the brace bar, which is one of the elements of the combination covered by the patent of the plaintiff, is not nor is its equivalent found in the machines made and sold by them. It is plain, upon an inspection of the drawings, that the defendants do not use a brace bar similar in shape or position to that described in the plaintiff's patent.

"But the plaintiffs insist that the top of the shank, curved as shown in the Thomas patent, is the equivalent of the brace bar forming one of the elements of their invention; and as the contrivance of the defendants embodies this equivalent device in combination with all the other elements covered by the plaintiffs' patent, that the infringement is established. Whether the first mentioned device is the equivalent of the latter is the question for solution. We think the contention of the defendants that it is not is well grounded. The specification and drawings of the plaintiffs' patent, and the testimony of the plaintiffs' witnesses, show that one purpose of the brace bar, used in the plaintiffs' combination, was to strengthen and support the shank between the tooth and the beam. The use of the brace bar enabled the plaintiffs to make the shank with less material and, at the same time, to increase its strength. This function is not performed by the curved portion of the shank used by the defendants, which has not the slightest tendency to support and strengthen the shank between the tooth and the beam, where the greatest strain comes. On the contrary, the defendants, by reason of the absence of the brace bar, are forced to make their shank of larger diameter than that used by the plaintiffs in order to give it the requisite strength to prevent bending. Instead of stiffening the shank between the tooth and the beam, it rather brings an increased strain upon that part of the shank. We find, therefore, that the curved upper part of the shank used by defendants does not perform one of the material functions of the brace bar of the plaintiffs' combination. It cannot, therefore, be the equivalent of the latter. For where one patented combination is asserted to be an

infringement of another, a device in one to be the equivalent of a device in the other must perform the same functions.

"As, therefore, there is one element of the plaintiffs' patented combination which the defendants do not use and for which they do not employ an equivalant, it follows that they do not infringe the plaintiffs' patent."

In *Dry Hand Mop Co. v. Squeez-ezy Mop Co.*, 17 F. (2d) 465 (C.A. 5, 1927), two patents were involved and both were held not infringed because the accused devices did not use one or more of the elements of the combination. We direct attention to the second of such patents, No. 1,427,478 for a mop head into which a detachable handle could be inserted and withdrawn. The court's analysis of the patent and of the accused device at page 467 is as follows:

"In patent 1,427,478 there are five claims. Detachable mop handles were not new in the mop industry or art when this patent was issued. The only novelty existing in the patent was in the means adopted to prevent circumferential slipping of the covering around the ferrule, when the mop was being wrung out. The prior art contained means for preventing such slipping. Fischer's patent accomplished it by a screw in the ferrule, and Hill's patent by a pin through the ferrule. Some of the claims of plaintiff's patent claim for means to prevent slipping generally. When reference is made to the state of the prior art, it is clear that such claims would be void, if interpreted, without relation to specific means. Claim

1 describes the means specifically as 'longitudinal rib'; claim 4, as 'a rib on the ferrule'; claim 5, as 'an interrupted rib on the ferrule.'"

"We construe the remaining claims as restricted to like means. The patent is valid only so far as it improved upon the then prior art in mop heads, and this was only to the extent of providing a new means for preventing circumferential slipping in the mop material, when the mop was being wrung out. The specific means were ribs on the ferrule, longitudinal or interrupted. The patented device could be infringed only by a construction that used the same means or their identical equivalent. The defendant's device used prongs or hooks punched through the ferrule to prevent the slipping. In view of the evidence, in the record and the opinions of the experts, we do not think that defendant's prongs and hooks were the longitudinal or interrupted ribs of the plaintiff's assignor or identical therewith. *Considering the narrow scope of the patent, that it must be limited to particular means of preventing slipping by the use of ribs, and the fact that defendant does not use ribs, but uses prongs or hooks on its mop head, the defendant's device did not come into collision with the plaintiff's patent.*" (Italics ours.)

Additional cases which may be of some aid because of their clear cut analysis of a patent as compared to an accused structure are the following: *Getty v. Kinzbach Tool Co.*, 119 F. 2d 249 (C.A. 5, 1941), cert. den. 314 U.S. 651, 86 L.Ed. 522; *Texas Rubber & Specialty Corp. v. D & M Machine Works*, 81 F. 2d 206 (C.A. 5, 1936); *Dow Chemical Co. v. Skinner*, 197 F. 2d 807 (C.A. 6,

1952); *Jogger Mfg. Corp. v. Roquemore*, 118 F. 2d 867 (C.A. 7, 1941). cer. den. 314 U.S. 629, 86 L.Ed. 505; *McKays Co. v. Penn Electric Switch Co.*, 60 F. 2d 762 (C.A. 8, 1932); *Electric Protection Co. v. American Bank Protection Co.*, 184 F. 916 (C.A. 8, 1911).

Claims 1 and 2

Claims 1 and 2 are identical in wording through element 5 and have been set up on Defendants' exhibit 215, the original of which is before the court. Element 5 of claims 1 and 2 reads:

> "A rod having pivotal connection with the fulcrum member and extending through an elongated opening in said shank and through a registering opening of the bracket bracket to anchor the shank to said bracket and provide sufficient longitudinal relative movement between the shank and fulcrum member to accommodate oscillation of the shank on the bracket."

It is immediately clear that this element is not literally present in the Jeoffroy structure. Jeoffroy provides two rods, neither of which pass through the shank. The rods are not pivotally connected to the fulcrum member but rather are connected by means of the square heads thereof engaging with square sockets in the fulcrum member, with the rods remaining in a substantially vertical position relative to the fulcrum member at all times. There is no elongated opening in the Jeoffroy shank. The rod does not anchor the shank to the bracket and there is no

longitudinal relative movement between the shank and the fulcrum member. (R. 809-14, 816-18, 821-22, and Finding of Fact XVIII, R. 26-27). The elements not being literally present the question is whether the differences are mere colorable differences that are not really differences in substance. *We believe it is clear that the differences are of substance.*

Claims 1 and 2, of course, are specific structural claims setting up the combination of the specific means used by Graham and the specific manner of arrangement disclosed in the description and drawings. The spring rod structure as revealed and claimed here in element 5 of claims 1 and 2 clearly discloses that the rod in Graham performs a dual function, i.e., the function of transmitting the spring pressure and the function of attaching the shank to the clamp to prevent it from being pulled therefrom and to carry the pulling load of the plow shank. With this structure the elongated opening in the shank and the longitudinal relative movement between the shank and the fulcrum member is absolutely necessary to the functioning of the device. Without such elongated opening in the shank and such longitudinal relative movement between the shank and the fulcrum member, the rod, during the tripping function, would be subject to binding and shearing forces which would seriously interfere with the operation of the device. (R. 121, 172) Likewise, with the rod performing the load carrying function the pivotal connection between the road and the fulcrum member is

necessary for operation. Furthermore, the patentee Graham has declared the longitudinal relative movement between the shank and fulcrum member to be an important and essential part of his structure and patent claims (R. 119-120, 124-25, 127, 146), and he sought to show that Defendants' device has such longitudinal movement by reason of the manufacturing tolerance in the nib and socket fittings which would increase with wear.

If there is invention in Graham over the prior art that invention resides in the fulcrum member arrangement and the method of attaching the shank. The foregoing matters therefore clearly go to the inventive step claimed by Graham and not merely to environment and thus limit the scope of the claims. See *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 F. 236 (C.A. 6, 1919); *McKays Co. v. Penn Electric Switch Co.*, 60 F. 2d 762 (C.A. 8, 1932); *Valjean v. Perfection Stove Co.*, 103 F. 2d 60 (C.A. 6, 1939); *Electric Protection Co. v. American Bank Protection Co.*, 184 F. 916 (C.A. 8, 1911); *Dry Hand Mop Co. v. Squeez-ezy Mop Co.*, 17 F. 2d 465 C.A. 5, 1927). Under these authorities we believe a fair interpretation of claims 1 and 2 limits those claims to a structure with a fulcrum plate and spring rod arrangement substantially as described with the sliding or longitudinal relative movement between the shank and fulcrum member.

Comparing the accused structures of Defendants then we find that no part of the pulling load of the shank is

carried by the spring rods and they do not attach the shank in or to the mounting. The spring rods are left free and clear of binding forces in order to perform their sole function of transmitting the spring pressure to the shank to permit the tripping of the plow tool when excessive forces are encountered. The spring rod does not serve to maintain the shank in position. That function is performed by the interlocking nibs and grooves on the fulcrum member and the shank. While there is some small degree of play between the nib and socket fittings, such play is not a deliberately designed feature, is not necessary to the operation of the device, and results solely from manufacturing tolerances. (Finding of Fact XVIII, R. 26-27) The nib construction on Defendants' shanks was used long prior to Graham's alleged invention as a stop to prevent the shank from being pulled out of the old fixed or rigid clamp, and this feature was retained in the shank and accommodated to interlock with a similar nib or socket on the fulcrum member and the bracket to prevent the shank from being pulled out of the device and to carry the load of the shank through the fulcrum member to the rear pivot pin. (R. 503)

In the prior art, as we have pointed out under our discussion of invention, there were many devices wherein a separate fulcrum member was used and the shank was attached to the fulcrum member by means of bolts, rivets, or other attaching means. Graham departed from the prior art in the respect that he did not use a separate

means of attaching the shank to the fulcrum member but rather provided for the spring rod to perform that function in addition to its function of transmitting the spring pressure. If combining the functions of two separate elements into one element constitutes invention sufficient to support his patent it likewise constitutes a limitation upon the scope of equivalents which he can claim. Jeoffroy has not attached the shank to the fulcrum member either in the precise manner of the prior art or in the manner of Graham, but in a manner somewhat different from both.

We are not naive enough to contend that the simple use of two springs instead of one amounts to a difference of any consequence; nor do we contend that a mere separation of one part into two parts avoids infringement. *But we do say that where the resulting structure functions in a different manner so that the parts do not operate and cooperate with each other in the same manner as the patent structure then the differences are matters of substance which do avoid infringement. That is the case here.* Plaintiffs, of course, urge that Defendants' spring rods plus their nib and socket fittings of the fulcrum member and shank perform exactly the same function in substantially the same manner as does the spring rod in the patent structure. But a mere recitation of the rule of thumb that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they

differ in name, form, or shape," will not suffice as a basis of analysis. It may suffice as a basis for stating a conclusion, but an analysis of whether they do work in subtantially the same way *must cut deeper.* In order to constitute the substantial identity necessary for mechanical equivalence, it is not only necessary that the result be the same, it is also necessary that the parts or elements operate and cooperate in the same manner to produce that result. *Electric Protection Co. v. American Bank Protection Co.*, 184 F. 916 (C.A. 8, 1911); *Wheat v. Ford Motor Co.*, 118 F. 2d 612 (C.A. 8, 1941); *Brandtjen & Kluge v. Joseph Freeman, Inc.*, 89 F. 2d 25 (C.A. 2, 1937); *Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co.*, 194 F. 2d 945 (C.A. 7, 1952). In the latter case at page 947 the court said:

> "There must be real identity of means, operation, and result. *** Thus, where a device is so far changed in principle that it achieves the same result by a different mode of operation, it is not an equivalent of the patented structure or an infringement of the claim even though it may fall within the literal words of the claim."

See also, *Walker on Patents* (Deller's Edition, 1937) Vol. 3, § 468. And consider the simple example of *Chicago Forging & Mfg. Co. v. Bade-Cummings Mfg. Co.*, 63 F. 2d 928 (C.A. 6, 1933).

Element 5 of claims 1 and 2 are not literally or substantially present in the Jeoffroy structure. The means

used by Jeoffroy are not the same, the manner of operation and cooperation is not the same, and the result is not the same. Element 5 is missing, therefore claims 1 and 2 are not infringed.

At this ponnt it should be pointed out that Graham made a vigorous effort to prove that the Jeoffroy structure does have a longitudinal movement of the shank relative to the fulcrum member and sought to show that Defendants' device has such longitudinal movement by reason of the manufacturing tolerance in the nib and socket fittings which would increase with wear. (R. 147-49, 193, 205, 228, 975-77) but as we have already pointed out the Trial Court found that whatever longitudinal movement there is in Jeoffroy results solely from manufacturing tolerance in the nib and socket fittings, that such motion was not deliberately designed into the device and such motion is not necessary to the function of the device and performs no useful purpose. That finding alone should have been sufficient to avoid the claim of infringement of claims 1 and 2 under the authority of *Price-Trawick v. Gas Lift Corp.*, 101 F. 2d 134 (C.A. 5, 1939), but both the Trial Court and the Court of Appeals disregarded the *Price-Trawick* decision. In that case the Fifth Circuit squarely held that a wobble in an accused structure produced by necessary manufacturing tolerances was not the wobble claimed in the patent. The analysis which was good in the *Price-Trawick* case is good here. Element 5 of claims 1 and 2 specifies a longi-

tudinal movement which is a part of and essential to its method of operation. That longitudinal movement is not a part of Jeoffroy's method of operation; it is not essential to operation and it is present only by reason manufacturing tolerances. That will not suffice for infringement.

Claim 3

Claim 3 of the patent is not in suit, but we believe it material to refer to that claim as shedding light upon a proper interpretation of the other claims and their application to the accused structures of Defendants. Claim 3 calls for a fulcrum plate having a transverse groove intersected by an opening through said fulcrum plate and registering with elongated opening in the shank and bracket, a rod extending through said openings and having a T-shaped head engaged in said groove, et cetera. Plaintiffs do not claim that Defendants' structure infringes claim 3. *The reason is obvious.* Claim 3 specifies a particular form or shape for the fulcrum element and the spring rod element. Those are the elements as specifically disclosed in the description and drawings. Defendants do not use those forms or shapes, and, of course, under well settled rules therefore do not infringe. *But the rule is broader than that.*

> "Where the claim defines an element in terms of its form, material, *location*, or *function* thereby apparently creating an express limitation, where that limitation pertains to the inventive step rather than

> to its mere environment, and where it imports a substantial function which the patentee considered of importance to his invention, the court cannot be permitted to say that other forms, which the inventor thus declared are equivalent to what he claimed as his invention, are nevertheless to be treated as equivalents, even though the court may conclude that his actual invention was of a scope which would have permitted the broader equivalency." *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 F. 236, 240 (C.A. 6, 1919.) (Italics ours.)

Claim 4

Claim 4 is substantially the same as claims 1 and 2. See defendants' exhibit 216, the original of which is before the court, and R. 822-823. Element 7 of claim 4 reads:

> "A rod pivotally connected with the fulcrum plate and extending through registering openings in said shank and bracket to anchor the shank for limited logitudinal movement on the fulcrum plate."

There is no real difference between element 7 in claim 4 and element 5 in claims 1 and 2. The spring rod is claimed in terms of its *position* relative to the other parts, its pivotal connection with the fulcrum member, and its *function* of anchoring the shank for limited longitudinal movement of the shank on the fulcrum plate. The position and function is the same as in claims 1 and 2. Only the words are different. It is apparent therefore that the same distinctions as have been pointed out in connection

with element 5 of claims 1 and 2 apply equally well to element 7 of claim 4, and for the same reasons there is no infringement of claim 4.

Claims 5 and 6

Claims 5 through 8 are general claims far less definite and specific than claims 1 through 4, and many of the so-called "means" can be given substance only by reference to the preceding specific claim or to the description and drawings. Under such circumstances, as we have already pointed out, pp. ~~63-69~~ 65-72, supra, in a secondary or limited patent such as this patent is *the vague means must be construed to be substantially the means or parts disclosed in the drawing and description or in the more specific claims.* Unless the vague and indefinite claims are so construed the claims are void as containing an insufficient and indefinite setting out of the invention and as being broader than the invention. In considerig the proper scope to be accorded these general claims we think it is interesting to note that they are all substitute claims which were filed in the Patent Office September 2, 1949 (R. 1311-1318), *well over a year after defendants started the manufacture and sale of their spring trips.*

Claims 5 and 6 are identical except for the last element of claim 6. They have been combined for comparison on Defendant's exhibit 217 which is before the court. Elements 5 and 8 of claims 5 and 6 are not present in the Jeoffroy structure. (R. 823-825) Element 5 reads:

"The shank having an end portion thereof between said parts and in movable engagement with the said parts."

Of course, there is nothing indefinite about the positioning of the shank between the said parts, i.e. between the bracket and the fulcrum plate, and of course that positioning is present in Jeoffroy. But the portion of the element specifying the shank to be in movable engagement with said parts is not met.

The term "movable engagement" in ordinary parlance is of course easily understood, and Plaintiffs' counsel would like to say (R. 238) that the term as here used does not necessarily mean longitudinal movement between the shank and fulcrum member, though his expert had previously testified that it did. (R. 233). Of course the shank is in movable engagement with the bracket or fixed member in the sense that it is free to move vertically in an arc away from the bracket during the tripping operation, just as all the shanks in the prior art are arranged to move relative to the fixed member in order to carry out the tripping function. *But there is more to the element than that.* The element calls for movable engagement with the said *parts*, both the bracket and the fulcrum member. In the specifications, column 5, lines 60-69 (R. 1029) the movable engagement of the shank with the fulcrum member during the tripping or rocking movement of the shanks is described as:

> "There is a slight *longitudinal* movement of the shank on the fulcrum plate."

Further, as we have already pointed out in connection with claims 1, 2 and 4 the movement of the shank relative to the fulcrum member is there specified as a longitudinal movement. As has also been pointed out the longitudinal movement of the shank relative to the fulcrum member in the Graham structure is absolutely necessary and essential to its operation. Otherwise there would be such binding and shearing forces on the spring rod as to impede the action of the spring. Certainly the movable engagement as here claimed means the relative longitudinal movement of the shank upon the fulcrum member. *This is not a mere play on words.* The longitudinal relative movement of the shank on the fulcrum plate is the necessary result of Graham's structure and is the essence of his mode of operation. There is no such movement present in Jeoffroy.

But it is contended, and the courts below have said, "claims 5 and 6 do not specify longitudinal movement". If the words do not mean longitudinal movement then what other movement are they speaking of? There is no lateral movement of consequence because the bracket portion both of Graham and Jeoffroy is of a more or less channel shaped formation to provide lateral support for the shank and to restrict or prevent lateral movement of the shank. Certainly the patent is not speaking of lateral movement. Then what about vertical movement? As we

have already stated the shank in Graham, in Jeoffroy and in the prior art devices is free to move vertically relative to the fixed or bracket member—otherwise there could be no tripping or spring action. Conceivably in the Graham structure it is possible that there could be some vertical movement of the shank relative to the fulcrum member and the device remain operative since the spring rod is inserted through the shank, and it is not necessary for the fulcrum member to be in contact with the shank to prevent the shank from being pulled out of the mounting. Such vertical movement is a possibility but hardly a probability. Under any condition of operation with any force whatever on the plow tool an upward and rearward force is imparted to the shank which causes the shank to pivot or fulcrum upon a point on the lower rear face of the bracket member where the shank emerges from the bracket. Consequently the forward end of the shank tends to move constantly downward against the fulcrum member. This downward force on the forward part of the shank and fulcrum member is in turn opposed by the upward force of the coil spring which results in a constant and continuous pressure of the forward end of the shank downward against the fulcrum member and an upward force of the fulcrum member against the shank. This more or less constant and continuous pressure of the shank against the fulcrum plate and the fulcrum plate against the shank is spelled out more particularly in claims 7 and 8. It hardly seems possible that element 5 of claims 5 and

6 is speaking of a vertical movement of the shank relative to the fulcrum member. If it is, however, then such movement is not present in Jeoffroy and has no application to the Jeoffroy structure. It is quickly noted that the only means for holding the Jeoffroy shank in the mounting is the nib and socket fittings of the bracket, shank and fulcrum member. As the shank and fulcrum member move downward in the tripping function away from the bracket member the upper nib on the shank no longer engages the corresponding socket of the bracket, and the shank is held in the mounting solely by means of the interlocking of the lower socket of the shank with the upper nib of the fulcrum member. If during the tripping function the Jeoffroy shank should move vertically away from the fulcrum member the nib and socket would immediately become disengaged and the shank would be pulled out of its operating position thus becoming an inoperative device. If the langauage of element 5 of claims 5 and 6 means a vertical movement of the shank relative to the fulcrum member it has no application to the Jeoffroy structure. This detailed analysis leads us to the simple and plain conclusion that the movement intended in element 5 is precisely the same as that stated in the specifications and in the more specific claim, i.e. longitudinal movement of the shank relative to the fulcrum member. But regardless of what movement is meant it has no application to the ~~Graham~~ Jeoffroy structure since there is *no movement* of the Jeoffroy shank relative to the fulcrum member except that which is permitted by manufacturing tolerances.

Element 8 of claims 5 and 6 also is not present in the Jeoffroy structure. This element reads:

> "Means on one of the parts engagable with a part of the end portion of the shank to prevent disengagement of the shank from the clamp but to allow same to rock."

This element calls for a means which performs a dual function, that is to maintain the shank in position and at the same time to allow it to rock, or in other words to transmit the spring pressure which permits the shank to pivot or rock. This means so described can have reference only to the spring rod which in Graham does maintain the shank in position and at the same time transmits the spring pressure. The Trial Court found that this double function of the rod is one of the special points of novelty of the Graham structure. (See next to last paragraph of court's letter, Appendix "A" of this brief.) As we have already pointed out several times this double function of the spring rod in Graham is a feature which is different from the prior art in that in the prior art in most instances the function of attaching the shank to the fulcrum member and holding it in the device was done by a separate bolt or rivets or other fastening means and the spring rod was left free to perform its function of transmitting the spring pressure.

In Jeoffroy the nib and socket arrangement of the shank and plate perform the function of holding the shank in the mounting. The spring rods perform the

separate function of transmitting the spring pressure. The nib and socket fittings have nothing to do with the tripping action, and the spring rods have nothing to do with holding the shank in the mounting. Jeoffroy has divided these functions as was common in the prior art. If Graham's combination of these functions under one element distinguishes his device from the prior art so as to support a valid patent, then the same unification of functions under one element will not permit the element to be read on the Jeoffroy structure which divides the two functions in the manner of the prior art.

Neither element 5 nor element 8 of claims 5 and 6 is present in Jeoffroy, accordingly claims 5 and 6 are not infringed.

Claims 7 and 8

Claims 7 and 8, as diagrammed on the claim chart, Defendants' exhibit 218, which is before the court, are identical except for the last part of claim 8 which describes the bracket member as being of channel shape formation.

Element 8 in each of said claims is not present in Jeoffroy. (R. 825). That element provides:

> "Said shank having a part thereof in stop engagement with one of said members to limit movement of the shank relatively to the clamping portion of the hinged clamping member when the shank is under rocking movement."

This description of the shank arrangement is somewhat misdescriptive of the Graham structure as revealed in the patent drawings because the word "members" is not completely clear. If that word refers to the bracket member and the fulcrum member, it is clear of course that the Graham shank is not literally in stop engagement with either of said members. The shank is stopped or held by the spring rod which is in contact both with the fixed member and the movable member; thus indirectly the shank is in stop engagement with either or both of the members in Graham. The function of the stop engagement as here claimed is "to *limit* the movement of the shank relatively to the clamping portion of the hinged clamping member when the shank is under rocking movement." The term "to limit movement" does not mean to *eliminate* movement entirely; it means to *permit* movement within a restricted range. Unquestionably, this is the same movement which is mentioned as "movable engagement" in element 5 of claims 5 and 6, the same as the "limited longitudinal movement on the fulcrum plate" in element 7 of claim 4, and the "sufficient longitudinal relative movement between the shank and fulcrum member" in element 5 of claims 1 and 2.

As we have already pointed out at length in connection with the other claims such longitudinal motion of the shank relative to the fulcrum member is a function and method of operation which is foreign to the Jeoffroy structure. But such motion is of the essence of the Gra-

ham structure which necessarily results from the method of attachment of the shank used by him and which is absolutely necessary to the functioning of his device. That is his method of operation, his manner of interacting cooperation of the parts. It is not the method of operation of the Jeoffroy structure; it is not the Jeoffroy method of interacting cooperation of the parts.

Plaintiffs of course assert that the nib and socket fittings of the Jeoffroy shank and fulcrum member satisfy this element since they do provide the stop engagement of the shank. Certainly the nib and socket arrangement does provide the stop engagement, does attach the shank to the fulcrum member, and does hold the shank in the mounting, but it does not provide or permit any limited movement of the shank relative to the fulcrum member longitudinally, vertically or any other way. There simply is no movement of the shank relative to the fulcrum member provided or permitted by the Jeoffroy structure except such movement as is permitted by manufacturing tolerance of the nib and socket fittings. That will not suffice to make out infringement.

In summary we respectfully submit that if the Graham patent is valid it is for a limited structure with a peculiar or particular method of attaching the shank which results in a peculiar or particular method of operation or interaction and cooperation of the parts. Jeoffroy does not literally use the structure as revealed in the description and drawings or as specified in the claims. The

Jeoffroy structure does not function in the same manner and the elements do not operate and cooperate in the same manner. Jeoffroy is not literally or substantially the equivalent of the Graham structure; accordingly there is no infringement.

VI. CONCLUSION

It is respectfully submitted that the courts below have erred in each of the respects assigned and that this case is one calling for the exercise by this Court of its supervisory powers by granting a writ of certiorari and thereafter reviewing and reversing the decision of the courts below.

DATED the 31 day of December, 1953.

W. W. GIBSON AND S. TOM MORRIS
630 Amarillo Building
Amarillo, Texas

Attorneys for Petitioners

By W. W. Gibson

Service on counsel for Respondents of a copy of the above brief this the ——day of ————, 19—— is hereby acknowledged.

.....

Attorney for Respondents

APPENDIX "A"

UNITED STATES DISTRICT COURT

for the

NORTHERN DISTRICT OF TEXAS

Joseph B. Dooley
U. S. District Judge

Amarillo, Texas
April 12, 1952

Gibson, Ochsner, Harlan, Kinney & Morris
630 Amarillo Building
Amarillo, Texas

Re: Graham, et al v. Jeoffroy Mfg., Inc., et al, No. 1204 Civil
Amarillo Division

Gentlemen:

The defendants' motions, first to amend the findings of fact and conclusions of law, and second to alter or amend judgment, and third for a new trial, are each overruled and you are directed to present proper order Monday, April 14.

In the first said motion number one specification repeats the request you previously raised and discussed in informal meeting that other features related to the special aspect of invention in plaintiffs' patent be stated. The findings and conclusions are already extensive and should not be needlessly enlarged, but I do not mind explaining my views further to counsel as a matter of information. The Graham fulcrum plate is novel in having a back pivot in loose contact allowing free pivotal motion of the plate and yet firmly holding it in place against any longitudinal or horizontal movement, and his said fulcrum

plate is novel in having radial movement up and down through the opening way and is novel in having a pivot on both ends, that is the fixed pivot pin at the back and the moveable T head pivot at the front, and the whole bracket or fulcrum assembly is novel in having the two fulcrums, one against the rigid face or place above the shank where it enters the bracket and the other at the front end of the fulcrum plate beneath the shank, and probably the other end of the fulcrum plate also becomes a fulcrum in some movements.

The moveable fulcrum plate below and the rigid bracket face above clampingly and yet yieldingly hold the front end of the shank in between when same is in place and as I recall that is another novel arrangement.

The spring rod does the double duty of a link to transmit the force of the spring tension to the fulcrum plate and shank and a brake to limit the backward play of the shank in the bracket.

The whole bracket shows the further novelty of having only one compact housing or attachment for the shank between its beam end and its ground end, with the object of anchoring the shank while retaining unusual motility, in order on one hand that the free resiliency of the shank and tool will carry same over rocks and other obstructions in the soil, and on the other hand will facilitate the pumping action and plowing performance in operation.

Trusting that this is the desired information, I am

Sincerely yours,

Joseph B. Dooley
United States District Judge

cc: Underwood, Wilson, Sutton, Heare & Boyce
Amarillo, Texas

DL 15

FILED
JAN 29 1954
HAROLD B. WILLEY, Clerk

In the Supreme Court of the United States

October Term, A.D., 1953.

No. 519.

JEOFFROY MFG., INC., ROY JEOFFROY AND RAY L. JEOFFROY,
Petitioners,

vs.

WILLIAM T. GRAHAM AND GRAHAM-HOERME PLOW CO., INC.,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

May It Please the Court:

INTRODUCTION.

This is a usual patent infringement suit brought by respondents in the United States District Court for the Northern District of Texas, charging petitioners with infringement of United States Letters Patent No. 2,493,811, issued January 10, 1950, for "Vibrating Plow and Mounting Therefor" (Plts'. Ex. 2, R. 1024, Vol. II). The trial court, after full and complete hearing, filed

its letter-opinion of September 30, 1951, holding the patent both valid and infringed (R. 14, Vol. I). Comprehensive Findings of Fact and Conclusions of Law were filed on December 31, 1951 (R. 20, Vol. I) and a judgment was entered January 5, 1952 (R. 29, Vol. I).

Petitioners duly filed their appeal to the United States Court of Appeals for the Fifth Circuit and the opinion, filed September 9, 1953, for which review is sought by petitioners, of the Court of Appeals for the Fifth Circuit is reported at 206 F. 2d 772, in the Advance Sheet dated October 26, 1953. The court of appeals affirmed the trial court on both questions of validity and infringement, and a rehearing was denied October 7, 1953 (R. 1374, Vol. III).

No Conflict of Decisions.

The patent involved was issued on January 10, 1950. This is the only decision that has been rendered upon it, except the same trial court recently passed upon infringement of the patent by petitioner, Jeoffroy Mfg. Co., on a different structure. There is no allegation in the petition of conflict of decisions regarding the patent, and, in fact, there is none.

Under such circumstances the petition should be denied. In *Keller* v. *Adams-Campbell Company,* 264 U. S. 314, 68 L. Ed. 705, 708, 44 S. Ct. 356, this Court said:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent."

See also:

Hamilton-Brown Shoe Company v. *Wolf Bros. & Company,* 240 U. S. 251, 60 L. Ed. 629, 633, 36 S. Ct. 269.

Decisions Not in Conflict With Established Law.

Petitioners have cited decisions of this Court holding other patents invalid or not infringed, but such decisions were in cases involving facts and circumstances clearly distinguishable from those of the present case. The Court of Appeals for the Fifth Circuit, in deciding the present case, followed other decisions of this Court more pertinent to the facts and circumstances of the present case. Under such circumstances the petition should be denied.

In *Forsyth* v. *Hammond,* 166 U. S. 506, 41 L. Ed. 1095, 1098, 17 S. Ct. 665, this Court said:

> "We reaffirm in this case the propositions heretofore announced, to-wit, that the power of this court in certiorari extends to every case pending in the circuit courts of appeal, and may be exercised at any time during such pendency, provided the case is one which but for this provision of the statute would be finally determined in that court. And further, that while this power is coextensive with all possible necessities and sufficient to secure to this court a final control over the litigation in all the courts of appeal, it is a power which will be sparingly exercised, and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more courts of appeal, or between courts of appeal and the courts of a state, or some matter affecting the interests of this nation in its internal or external relations, demands such exercise."

The petition involves no special or important question pertaining to the patent, but attacks for the third time its validity. Granting of the writ will require a review by this Court of the somewhat voluminous record and exhibits for the purpose of testing the soundness of the District Court's Finding of Fact, on which validity of the

patent was based, which findings were the basis of the two concurrent decisions below. The gist of the controversy is illustrated in the court of appeals' opinion wherein Rives, Circuit Judge, said (R. 1363, Vol. III):

> "We think appellants fail to give due consideration to the fact that the District Court not only found novelty in certain structural features of the Graham device, but further found that the combination itself produced a new and useful result which amounted to invention. Without detailing its structural features at great length, it seems to us that, from the evidence and the various exhibits, the District Court was justified in its findings of novelty in the Graham fulcrum assembly and its unique method of operation (see footnote (6), *supra*)."

It is clear, from petitioners' petition (p. 3) under the heading "III. *Questions Presented,*" that they merely seek a review by this Court of the facts in this case, wherein they allege, under paragraphs "A" and "B," that the courts below err in applying inappropriate standards of invention and in holding the patent in suit infringed. Both of the lower courts held the patent valid and infringed after careful analysis of the evidence, the trial court having witnessed actual tests of the devices involved.

Petitioners' Reasons Relied on for the Allowance of the Writ.

"A."

Under this heading (Petition p. 3, Point IV. A) the petitioners state, "The courts below have failed to apply with sufficient strictness the criteria of invention laid down by this court for a combination patent in *Great A. & P. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147,

95 L. Ed. 162, 71 S. Ct. 127 (1950), and the decisions below are in conflict with that decision." Petitioners' fallacy here is they fail to recognize the facts of the present case are different from the facts of the A. & P. case.

The letter-opinion of the trial court (R. 14, Vol. I) and Appendix "A" attached to petioners' brief (p. 91) and the opinion of the court of appeals (R. 1355, Vol. III) on their faces answer petitioners' question "A," because they show the court applied to the patent in suit the high standards of invention required by this Court in the case of the *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equip. Corp.* This is admitted by petitioners by quoting parts of the opinions showing reference to the A. & P. case in their brief (pp. 18, 19).

The trial court (R. 16, Vol. I) stated that the decision in the A. & P. case undoubtedly tightens the validity test for a combination patent, *but it does not rule out such patents.* Undoubtedly, the trial court based its decision on the fact that in the A. & P. case the patent involved a combination of old elements with no change in their respective functions, whereas, in the present case the trial court found that there is structural novelty in the fulcrum assembly of the patent in suit and even greater merit in the reputed suitability of such structure for digging a scalloped pattern through the plowed earth, therefore, distinguishing from the A. & P. case (R. 16, Vol. I).

The trial court, in its letter of April 12, 1953 (Appendix "A" to petitioners' brief, p. 91), states that the Graham fulcrum plate is novel in having a back pivot in loose contact allowing free pivotal motion of the plate and firmly holding it in place against any longitudinal or horizontal movement; it is novel in having radial movement up and down through the opening way and is novel in having a pivot on both ends, that is, the fixed pivot pin at the back

and the movable T-head pivot at the front; the whole bracket or fulcrum assembly is novel in having the two fulcrums, one against the rigid face, or place above the shank where it enters the bracket and the other at the front end of the fulcrum plate beneath the shank, and probably the other end of the fulcrum plate also becomes a fulcrum in some movements.

The trial court found particularly that there was novelty in the movable fulcrum plate below and the rigid bracket face above, *clampingly and yet yieldingly holding the front end of the shank in between when in place.*

It further held that the spring rod does the double duty of a link to transmit the force of the spring tension to the fulcrum plate and shank and a brake to limit the backward play of the shank in the bracket and that the whole bracket shows the further novelty of having only one compact housing or attachment for the shank between its beam and its ground end with the object of anchoring the shank while retaining unusual motility in order, on one hand, that the free resiliency of the shank and tool will carry same over rocks and other obstructions in the soil, and on the other hand, will facilitate the pumping action and plowing performance in operation.

The Court of Appeals for the Fifth Circuit (R. 1362, Vol. III) agreed that the A. & P. case enunciated a more strict test of invention than existed before, but that the fact that some of the elements of the Graham structure were known to the prior art still would not preclude its validity or negative any invention therein, so long as the Graham combination produced a new and useful result in a substantially different way.

The Court of Appeals for the Fifth Circuit independently further found (R. 1363, Vol. III) the evidence fairly establishes that the patentee, Graham, was the first

to perfect the idea of *a resilient and frictional engagement of the shank of a ground working tool between a fixed part and a movable part,* between the bracket on the H-beam and the fulcrum plate pivotally mounted on the bracket. His production of an efficient mounting for a ground working tool shank that would permit it to rock or vibrate, and yet obviate the necessity of it being hinged directly on a fixed member, as in the Valley City device and the prior art, was novel both in method of operation and result accomplished, and entitled him to a valid patent on the combination claimed. The patent may not be invalidated under the test for invention laid down in the A. & P. Tea Co. case, involving uniting old elements "with no change in their respective functions," whereas the patent in suit here involved combines both old and new elements to produce a new result.

It is clear, therefore, from a reading of the opinions of the trial court and the Court of Appeals for the Fifth Circuit, that they fully considered the A. & P. case and applied the rule of law laid down by this Court in that decision. The only complaint petitioners have stated in their petition is the courts below failed to apply *with sufficient strictness* the criteria of invention laid down by this Court in the A. & P. case.

Respondents respectfully submit that the opinion of the court of appeals on its face answers petitioners' question. It clearly shows that it applied, to the patent in suit, the high standard of invention required by this Court in the A. & P. case. The record clearly shows that petitioners pressed hard their attack upon the patent as failing to meet the high standard of invention both in the trial court and the court of appeals and neither of these courts could have overlooked such high standard of invention referred to.

The decisions of the Fifth Circuit cited in its opinion (R. 1362), along with the A. & P. case, show that the Court of Appeals for the Fifth Circuit has consistently applied the doctrine that combination patents should be hard to obtain and when obtained, carefully scrutinized from a time antedating the A. & P. case. *Robertson Rock Bit Co.* v. *Hughes Tool Co.*, 176 F. 2d 783; *Ritchie* v. *Lewis Browning Mfg. Co.*, 196 F. 2d 434, 437, and *E-I-M Co., Inc.*, v. *Philadelphia Gear Works, Inc.*, 205 F. 2d 28.

The court of appeals carefully considered the Findings of Fact of the lower court and the petitioners' argument and brief before that court, and stated that the patent here involved combines both old and new elements to produce a new result (R. 1364). It should be noted that petitioners, in their brief before the court of appeals, conceded that Graham's structure exhibits differences in structure over the Valley City device and the prior art. (See Opinion, Footnote 7, R. 1360.)

In view of the foregoing it is evident that both courts below considered the patent in suit in keeping with the high and exacting standards of invention now prevailing, and that a review by this Court of the evidence to see if the findings are supported would serve only the interest of the parties in their private controversy. The Supreme Court is not merely a court of review to determine that findings of fact are properly substantiated by the evidence where concurring opinions of two lower courts exist. *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 86 L. Ed. 1537, 62 S. Ct. 1179; *Graver Tank & Mfg. Co., Inc.*, v. *Linde Air Products Co.*, 336 U. S. 271, 93 L. Ed. 672, 677, 69 S. Ct. 535; *Faulkner* v. *Gibbs*, 338 U. S. 267, 94 L. Ed. 62, 70 S. Ct. 25. The Supreme Court will not set aside concurrent findings of two courts except in a strong case. *Goodyear Tire & Rubber Co., Inc.*,

v. *Ray-O-Vac. Co.*, 321 U. S. 275, 88 L. Ed. 721, 64 S. Ct. 78; *Universal Oil Products Co.* v. *Globe Oil & Ref. Co.*, 322 U. S. 471, 88 L. Ed. 1399, 64 S. Ct. 1110.

It is clear from the Findings of Fact of the trial court (Nos. 7, 8, 10, 11, 12, 13, 14, 15 and 17, R. 23-25) that it carefully considered all of the prior art, both patented and otherwise and in Finding 16 (R. 25), that "none of the earlier patents cited, nor the other devices mentioned by the defendants, embodies the double fulcrum and other novel parts of the fulcrum assembly disclosed in the Graham patent, and the defendants fall short of showing any prior public use or anticipation of the invention in the said patent."

Respondents submit, therefore, it is ridiculous for petitioners to insist the courts below failed to apply the high standard of invention required by this Court in the A. & P. case.

"B."

Under this question the petitioners say the decisions below, on the question of invention, are in conflict with decisions of the Tenth Circuit and Eight Circuit, respectively, and cite the cases of *Hutchinson Mfg. Co.* v. *Mayrath,* 192 F. 2d 110, Tenth Circuit, and *Continental Farm Equipment Co., Inc.,* v. *Love Tractor,* 199 F. 2d 202, Eighth Circuit.

The allegation contained in petitioners' (Br. p. 4) paragraph "B," does not set out grounds for granting of a Petition for Certiorari. There is nothing in the record showing that the Court of Appeals of the Eighth and Tenth Circuits in the *Continental* and *Hutchinson* cases applied a different rule of law relating to invention in those cases than did the trial court and the Court of Appeals for the Fifth Circuit in the present case, as ob-

viously there were different patents, different pertinent prior art and different facts involved.

In the *Hutchinson* and *Continental* cases the courts found that there was clearly a combination of old elements united and when so united produced no new result. Therefore, there is no conflict in principle with the decisions cited and the present holding of the trial and appellate courts, because here both the lower courts have found there is a combination of elements, some new and some old, and they produce a new and different result.

"C."

Under this heading the petitioners say the decisions of the courts below, as to infringement, are in conflict with a decision of the Court of Claims and a decision in the Fifth Circuit Court of Appeals. Here again petitioners rely on a premise which has no place in patent law. Petitioners' allegation set out in paragraph "C" (Br. p. 4), therefore, does not form a basis for granting of a Petition for Certiorari. Infringement is a question of fact and obviously each case cited by petitioners involved different facts. Here again there is nothing in the record to show that the courts, in the cases cited by petitioners, applied the law differently than was applied by the trial court and the Court of Appeals for the Fifth Circuit in the present case.

The rule as to infringement of a patent has been very well and recently stated and is followed throughout the various circuits in the case of *Graver Tank & Mfg. Co., Inc.*, v. *Linde Air Products Co.*, 339 U. S. 605, 94 L. Ed. 1097, 1101, 70 S. Ct. 954, wherein the Supreme Court said that:

> "The theory on which it is founded is that 'if two devices do the same work in substantially the same

> way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.' *Union Paper-bag Machine Co.* v. *Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935, 936."

The decisions of the courts below, in the present case, are not in conflict with the rule of law laid down by the Supreme Court.

"D."

Under this heading the petitioners say the matter involved is of concern not only to these litigants, but to the public at large, in that the range of protection provided and the range of monopoly extended by the Patent Laws of the United States is involved.

The public has been greatly benefited by the invention of the patent in suit. Immediately when the respondents placed the device, disclosed in the patent in suit, upon the market the farmers accepted them and they solved their problems. The patent has enjoyed a substantial commercial success. At the time of Graham's entry into the field with this device, there was no other device available to accomplish the results accomplished by the device of the patent in suit.

Respondents submit this case does not present any special or important questions, and it is clear that petitioners are merely seeking to have the Supreme Court provide a third review of the evidence to determine whether the Findings of Fact are contrary to the evidence to serve their own private interest.

In *Fields* v. *United States*, 205 U. S. 292, 51 L. Ed. 807, 810, 27 S. Ct. 543, this Court said:

> "In this case there is no sufficient ground for a certiorari. The application comes within none of the con-

ditions therefor declared in the decisions of this court. However important the case may be to the applicant, the question involved is not one of gravity and general importance. There is no conflict between the decisions of state and Federal courts or between those of Federal courts of differenct circuits. There is nothing affecting the relations of this nation to foreign nations, and indeed no matter of general interest to the public."

Respondents respectfully submit that the question is not to find an authority for this Court to grant certiorari because that decision rests within the sound discretion of the Court. The question is what will be the nature of the review? Does it involve a question of gravity and great importance? Obviously in this case it would only be a third review of the facts to determine whether the facts support the Findings of Fact of the trial court, concurred in by the Court of Appeals for the Fifth Circuit, a function uniformly held by this Court to be outside the constitutional purpose of the Supreme Court. The petition should, therefore, be denied.

ARGUMENT.

Respondents submit that petitioners' brief does not conform to Rule 38, Paragraph 2, of the Supreme Court Rules, wherein it is specified that a supporting brief annexed to a Petition for Certiorari *must be direct and concise.*

Petitioners have merely reargued the case the same as they did before the trial court and the court of appeals. Petitioners' petition and voluminous brief clearly is not a presentation of any grounds which would justify granting of certiorari. On the contrary, it is a detailed argument relative to the evidence in the case and an attempt to induce the Supreme Court to consider and review the evidence which was carefully considered by the trial court and reviewed by the court of appeals. Under such circumstances and in accordance with the established practice in this Court, the petition should be denied. *United States* v. *Johnson,* 268 U. S. 220, 69 L. Ed. 925, 926, 45 S. Ct. 496; *Magnum Import Co.* v. *De Spoturno Coty,* 262 U. S. 159, 67 L. Ed. 922, 924, 43 S. Ct. 531. These cases hold that this Court will not grant certiorari to review evidence and discuss specific facts.

While respondents believe that the above sets forth sufficient grounds for denial of Writ of Certiorari in this case, petitioners' brief contains many inaccurate and misleading statements and brief reply will be made to petitioners' brief under the headings of "Invention" and "Infringement."

Invention.

Point "A"

Under this point in petitioners' brief they admit that there are novel elements in the Graham patent but merely

argue that such novel elements, even though they produce a new result, amounted to nothing more than mechanical skill. They admit that the patent in suit revealed structural novelty in the sense that no prior art patent or device reveals precisely the same shape, form, position or arrangement of parts.

Petitioners, at the trial of this case, introduced drawings of alleged prior art structures and including Helfeld's spring trip (which it is admitted is not prior art) showing what they termed fulcrum members. Should this Court desire to examine the prior art relied on by petitioners and the patent in suit as to the fulcrum assembly arrangement held to be particularly new and novel by both the trial court and the court of appeals, it is respectfully referred to defendant's Exhibit 204 and urged to compare the alleged fulcrum members (colored purple) shown on that chart with the fulcrum member of the patent in suit (Plts'. Ex. 2, R. 1024). Reference also could be had to colored drawings of the patent in suit (Defs'. Exs. 205 A, B, and C) and colored charts (Defs'. Exs. 209, 210, 211 and 212), with particular reference to Fig. 7 of the drawings of the patent in suit and the charts. Such examination will clearly show the prior art does not teach Graham's invention, nor does the prior art teach even a skilled mechanic how the Graham fulcrum assembly could be devised without exercise of invention. Furthermore, the prior art does not show the particular bracket arrangement and its mounting as disclosed in the patent in suit.

It is respectfully submitted that the combining of the elements by the patentee, Graham, particularly as illustrated and defined in claims 1, 2, 4, 5, 6, 7 and 8 of the patent in suit, which are the only claims here involved, is a combination of elements which amounts to invention.

The unification of such elements produces an unusual and surprising consequence and the unified whole exceeds the sum of the individual parts, as required by the rule laid down in the A. & P. case and upon which the petitioners rely in the present suit.

It is clear that the trial court and the court of appeals, after carefully considering the evidence, both came to this conclusion in their opinions as quoted in petitioners' brief (pp. 18 and 19).

While admitting in their brief before the court of appeals (See Footnote 7 of Opinion, R. 1360) and in their brief for their Petition for Certiorari (pp. 15, 40) that there were certain novel elements in Graham's structure, they say (Br. p. 20) that the lower courts assumed there was invention after having found novelty and usefulness in the Graham device and they now mistakenly use this reasoning as a basis for request that this Court review the evidence of the case.

The case cited by petitioners (Br. p. 20), *Ingersoll-Rand Co.* v. *Black & Decker Mfg. Co.*, 94 F. Supp. 938, 941, specifically sets out, after reference to the A. & P. case, that each case must be decided on its particular facts, and this is exactly what the trial court and the court of appeals did in the present case.

The petitioners' reference (Br. pp. 22, 32) to the specific prior patents to Dunbar, Carter, Rix (2), Cobb, Moore, Lamprell and Cook, Australian patent to Prior, Australian patent to Traeger and La Dow, merely sets out individual parts of such patents, but it must be noted that in none of these patents is it set out that there is a fulcrum assembly like that of the patent in suit and as particularly pointed out above in connection with defendants' Exhibit 204, wherein these particular alleged fulcrum members are shown in colored drawings.

The petitioners say in their brief (p. 34) that it is not necessary that all of the elements be found in one patent, but the case relied on (Br. p. 34), particularly the *Lyman Gunsight* case, does not help petitioners in this regard. In that case it says that if the elements "taken as a whole" could be found in prior patents and no new functional relationship arises from their combination there is no invention. Here, all of the elements are not found in the prior patents, and they are not found in their particular relationship as a whole. They produce a new result as found by both the trial court and the court of appeals and the whole exceeds the sum of the parts. It, therefore, meets the criterion laid down in the A. & P. case.

The Prior Art.

Petitioners have in their brief (pp. 22-32) referred specifically to the various prior patents relied upon, but it is respectfully urged that the construction placed on these patents by petitioners requires some further explanation if the Court desires to consider each one separately.

The *Dunbar* patent, No. 211,003 (R. 1191), includes a base plate "B" having aligned spaced eyes c to which a knuckle e is connected by hinge bolts d to form a hinge joint between the shackle plate D and the base plate B. A harrow tooth F is secured to the shackle plate D by clamping bolts g. The only clamping action is in the clamping of the tooth to the shackle plate in fixed relation thereto. There is no fulcrum plate and the tooth is not resiliently held between the member D and the bracket b (R. 843).

The *Carter* patent, No. 231,268 (R. 1149), includes the bracket or fixed part E mounted on a harrow beam A. A movable part, block or fulcrum member G is pivoted by means of its pivots L in a socket J on the fixed member. A ground working tool or tooth is not held or clamped between the block G and the fixed part E. It is mounted

on the movable part and is firmly held thereon so that actually the effect is the same as the pivoting of the shank directly on the fixed member.

The *Rix* patents, Nos. 246,417 (R. 1197) and 260,239 (R. 1201), both disclose harrow teeth, in the first of which the tooth is directly hinged on the beam and the spring applies pressure to the tooth to urge the lower end downwardly and forwardly. There are no clamping members in either of the Rix patents, the latter patent also merely showing the hinging of a tooth on a beam.

The *Moore* patent, No. 503,288 (R. 1205), discloses a bracket d attached to a cultivator beam. A cultivator shank b is pivoted on the bracket by trunnions e and are fixed to the shank by rivets f. The plate is merely hinged on the yoke, whereby it will jump stumps or other obstructions. As admitted by petitioners (Br. p. 29), it does not disclose a pivot pin or a fulcrum member of any kind.

The *Lamprell et al.* patent, No. 1,141,804 (R. 1212), discloses a cultivator having a tine a which is pivoted on a pin b carried by brackets c. The forward end of the tine is connected to a U-shaped bridle piece k that has a spring g for holding the forward end of the shank in working position. The shank of the ground working tool or tine is clearly hinged directly on the bracket and is not resiliently clamped between the brackets and a member movably mounted thereon such as a fulcrum plate. This is admitted by petitioners (Br. p. 30).

The *Australian* patent to *Prior* (R. 1246) shows the mounting of a cultivator tool whereby it will jump stumps or other obstructions. The forward end of the tooth 10 is folded over upon itself to form an eye which is hingedly mounted on a bolt as arranged between spaced plates of a block 6 which shows a spiral spring 16 having one end engaging the tooth or tine and the other end a washer

17. As admitted by petitioners (Br. p. 30) there is no spring rod or fulcrum member as disclosed in the Graham patent in suit. It will be noted that in actual operation forces applied to the ground working tool are transmitted directly to the pivot pin, whereas with the patent in suit the forces are partially transmitted to the fulcrum plate and then to the fulcrum pin.

The *Australian* patent to *Traeger* (R. 1249) discloses a spring tine for agricultural implements and, as admitted by petitioners (Br. p. 31), it does not disclose how the tine is attached to the fixed part or beam. *There is no fulcrum plate* in the sense of the Graham patent and particularly is there no fulcrum plate showing the end of the shank clampingly and frictionally held therebetween. The forward end of the shank is merely hinged on the block and not mounted for rocking movement in the manner that would result from the use of the structure such as specified in the claims of the patent in suit. In operation forces would be applied to the ground working tool and transmitted directly to the pivot pin as in any hinge mounting of such device. The function is entirely different, involving a different distribution of forces than that of the patent in suit. It does not disclose or teach a clamp having a fixed part and a movable part pivotally mounted on the fixed part with the forward end of the shank of the ground working tool held between said parts, regardless of the argument of petitioners (Br. p. 31).

The *La Dow* patent, No. 691,571 (R. 1264), is entitled "Elastic Joint," but primarily discloses a mounting of a harrow spike. The mounting consists of a channel shape support C arranged with flanges extending rearwardly of a vertical web portion. The spike A has its upper end extending into an opening of a saddle member B, the saddle member having a projection b which extends into

and seats in the channel of a support C. A leaf spring has one end engaging in a V-shape groove c and the other end extending through an opening in the saddle into engagement with the spike, whereby the spring holds the spike in the saddle and also holds the projection of the saddle into the channel of the support C. The ground working tool or spike is fixed in the saddle or in the portion which rocks relative to the support. There is no disclosure of a clamp with a shank of a ground working tool wherein the shank is held between a fixed part and a movable part pivoted on the fixed part of the clamp, nor as admitted by petitioners (Br. p. 31) is there a pivot or fulcrum pin.

The Valley City device has no fulcrum plate or assembly whatever. In fact, the shank is merely pivoted on the clamp by a pin, and, in this respect very closely follows the Lamprell *et al.* patent (R. 1212). The devising of this devise, therefore, has no bearing whatever on whether or not the patent in suit involves invention or merely mechanical skill.

It is respectfully submitted the two lower courts' decisions on the question of validity of the patent in suit are correct.

Infringement.

Point "B"

The trial court, after hearing voluminous evidence on the question of infringement of the patent in suit by petitioners' accused devices, at the suggestion of respondents, witnessed a test operation of one of petitioners' accused devices on one of respondents' plows, along with one of the patented devices, and made his findings of infringement after seeing this actual test of the respective devices

and weighing the evidence presented in open court. It is clear, therefore, from a reading of the opinion of the trial court, affirmed by the Court of Appeals for the Fifth Circuit, that the trial court very carefully considered the question of infringement and since he saw an actual operation of the devices his findings are entitled to great weight.

However, petitioners, in their brief before this Court, have gone into the question of infringement to considerable length, and particularly state that their devices, as exemplified by plaintiffs' Exhibits 6, 7 and 37, do not infringe any of the claims of the Graham patent for two reasons.

(1) Their device does not have a constant and continuous pumping action of the ground working tool, and

(2) One or more elements in each of the claims is not satisfied by the Jeoffroy structure.

A great deal of the time of the trial of this case, which lasted three weeks, was taken up by petitioners in an attempt to show that the accused devices did not have a *pumping action,* referred to in the specification of the patent in suit, even though the claims of the patent in suit do not specifically claim this pumping action. They are directed to a structure which when operating results in a pumping action.

The trial court, after viewing the test above mentioned, stated (R. 17) that, while petitioners claim that their device did not work with a pumping action or permit longitudinal movement of the attached shank, such as found in the Graham clamp, this contention did not go to the real subject of the invention. The patent is directed to the structure of a mechanism and the contention of petitioners deals with how it is said the mechanism works in operation. The court further found, after viewing this test, that

the accused clamp is actually capable of pumping action at times and has some little range of longitudinal movement in the shank. It did find that the Graham device had a greater pumping action but this was due to the difference in the sizes of the springs used by the respective parties. It further found (R. 18) that the pumping action could be regulated by loosening or tightening of the nuts on top of the spring or springs in either of the Jeoffroy or Graham structures.

Finding of Fact number XVII sets out the reference to the test by the trial court and while petitioners argue this was not a fair test, the record does not support such a statement. On the contrary, respondents' expert, Fenton, observed the device of respondents and one of the accused devices on a plow before the trial of this case and testified unequivocally that the accused device had a "pumping action" and the device performed in substantially the same manner as that of the patent in suit (R. 195, 196).

Petitioners state (Br. p. 58) that in the test referred to by respondents' expert "there was only one Jeoffroy mechanism mounted and the entire weight of that plow was riding on that one shank, in addition, at times there were one or two men standing on the frame of the plow as it operated to observe the action of the Jeoffroy mechanism." This statement is incorrect. At no time is the weight of the plow on one shank. The plow frame is supported by wheels near each end thereof and the raising and lowering of the frame with respect to the wheels determines the depth to which the shanks extend into the soil. The men standing on the frame have no effect whatever on the depth of the shank in the ground as the wheels prevent the shanks entering the ground to any depth other than that provided by the lever and frame mechanism.

Futhermore, the trial court walked along beside the

plow and behind the plow during the test and clearly observed the pumping action referred to and the mode of operation of the respective devices, and found the accused device an infringement of the patent in suit. Under such circumstances the trial court's holding will not be lightly set aside and, in fact, it has been said that they will only be set aside when found to be clearly erroneous. Now, on the question of infringement how can this Court say that his Findings were clearly erroneous when the trial court had the advantage of seeing a test of the devices in actual field practice, even though there was only one of petitioners' devices and one of respondents' devices on the plow frame. Very often plows with only four shanks are used in actual field operations when deep plowing is desired.

Ray Jeoffroy, one of the petitioners, testified that their device included a part or bracket fastened to the H-beam of the plow (R. 507). He said it had a hinge part of T-shape which moved downwardly when the shank hits a rock (R. 506) and the shank comes back to place after it moves over the rock, the same as plaintiffs' if plaintiffs' spring is strong enough (R. 507). The front part of the shank goes down when the lower part of the shank hits a rock. It has the nibs and recesses in the shank and bracket, respectively, to retain the shank in the clamp (R. 503); that the shank and hinge rock around the fulcrum pins (R. 505); the body portion of the clamp includes a channel (R. 508) in which the shank engages (R. 510); the shank is positioned between the upper part of the clamp and the hinge plate (R. 511); and the shank is held resiliently therebetween (R. 511) and the spring keeps the forward end of the hinge plate against the lower face of the forward end of the shank at all times.

Respondents' expert testified (R. 1000) that defendants'

device is designed for pumping. The only way you can avoid it is to put it down so tightly that you have no spring action or put it in soil where there is little or no resistance to the action of the plow.

Petitioners' efforts to make an issue out of the pumping action of the respective devices is nothing more than an attempt to cloud the issues in this case. The pumping action is not an element of the claims. (See *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 86 L. Ed. 1537, 1543, 62 S. Ct. 1179). There is no question but what petitioner's device exemplified by the exhibits before this Court operates in the same manner as called for in the claims of the patent in suit, and this was so found by both the trial court and the court of appeals.

It has been held many times by this Court that the theory on which infringement is found is that

> "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape. *Union Paper Bag Machine Co.* v. *Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935, 936; *Graver Tank & Manufacturing Co.* v. *Linde Air Prod. Co.*, 339 U. S. 605, 607, 94 L. Ed. 1097, 1101."

"Absence of Elements."

Under this heading (Br., p. 64) petitioners attempt to set out wherein the petitioners' structure does not include the elements of the claim of the patent in suit. Respondents contend that all of the elements, or their equivalents, are found in the accused devices. Petitioners do not come under the general rule that omission of an element avoids infringement, but under the rule of the *Graver Tank* case, *supra*.

At the trial of this case respondents' expert, Fenton, showed by colored drawings (Plts.' Exs. 15 to 21, incl.)

that each and every element or their equivalents of claims 1, 2, 4, 5, 6, 7 and 8 of the patent in suit is found in the petitioners' devices as exemplified by plaintiffs' Exhibits 6 and 7. Plaintiffs' Exhibits 15 to 21 are colored charts showing a figure of the drawings of the patent in suit and drawings of the accused structures and have the elements of the claims circled with lines and arrows running to the parts to which they refer and the coloring likewise showing the same elements. This Court is respectfully referred to such exhibits if it desires more detailed analysis of the claims with respect to the accused devices.

While it is true that petitioners' devices do not have the opening in the end of the shank with the spring rods extending therethrough, they provide the T-head on the fulcrum plate and have the recesses and nibs in the respective parts to substitute for the openings in the shank and the rod extending therethrough. This is merely an obvious attempt to evade the patent and certainly is an equivalent structure. What it amounts to is placing an opening part way through the shank and bracket and providing nibs on the fulcrum plate and shank to engage in the openings or recesses. The nibs hold the shank in the assembly the same as the spring rod through the end of the shank while the compression of the spring tends to urge the end of the fulcrum plate against the lower side of the shank and then to urge the shank against the bracket, the same as in the patent in suit.

Under the heading of "Claims 1 and 2," petitioners in their brief (p. 72) attempt to point out differences in the defendants' structure from such claims, and particularly refer to the rods of the Jeoffroy structure not being pivotally connected to the fulcrum member. While they do not have one rod extending through the shank and fulcrum member they have two rods and the heads of such

rods are attached to the T-head of the fulcrum member in a loosely fitting manner so that it allows for rocking movement when the clamp is opened upon hitting an obstruction.

Petitioners further say (Br., p. 73) that the function of the rod in the Graham patent as disclosed in element 5 of claims 1 and 2 is to transmit the spring pressure and also attach the shank to the clamp to prevent it from being pulled therefrom. Petitioners' accused device has the equivalent structure in the nib and socket arrangement as mentioned above to prevent pulling of the shank from the clamp and the two spring rods for transmitting spring pressure on the device.

Petitioners further say that the accused device does not have sufficient longitudinal movement between the shank and fulcrum member to accommodate oscillation of the shank on the bracket, but the respondents' witnesses testified that there was such longitudinal movement as called for in the claims in the accused device and the trial court after observing the field test also found such longitudinal movement wherein in his opinion (R. 17) he said the Jeoffroy clamp "has some little range of longitudinal movement in the shank," when the shank is working in tight soil or is set for deep plowing or is used to break sod, regardless of his finding (R. 27) that no longitudinal movement is intentionally designed into the accused devices, longitudinal movement is not necessary to the function of said devices and such longitudinal movement is that of manufacturing tolerances and operational wear in the nib and socket fittings of the shank, fulcrum member and bracket.

Petitioners admit (Br., p. 76) that the use of two springs instead of one amounts to a difference of no consequence nor a mere separation of one part into two parts avoids infringement, but they contend that where the resulting

structure functions in a different manner so that the parts do not operate and cooperate with each other in the same manner as the patented structure then the differences are matters of substance which do avoid infringement. They do not show wherein their structure functions in a different manner so that the parts do not operate and cooperate with each other. The nib and socket arrangement and two rods and springs of the accused device operate and cooperate with each other so that the end of the shank is clampingly and frictionally held between the fulcrum plate and bracket to produce the identical result required by the claims of the patent in suit.

The petitioners (Br., p. 78) say that the courts below erred in finding there was longitudinal movement of shank in the accused devices resulting solely from manufacturing tolerances in the nib and socket fittings. The courts below went further in their holdings, stating that the accused devices do have longitudinal movement when working in deep soil or sod. The petitioners here talk about manufacturing tolerance in the sense of a machined device. The devices here in question are not machined devices; they are made from castings and the manufacturing tolerances are greatly in excess of the usual tolerance observed in machined tools. In some of the devices before the Court there was a much as one-half inch movement in the shank and very noticeably at least a one-fourth inch longitudinal movement which is sufficient to come under the claims of the patent in suit which mention such longitudinal movement.

The *Price-Trawick, Inc.*, v. *Gas Lift Corporation* case (101 F. 2d 134) mentioned by petitioners (Br., p. 78) is not in point because there, there was involved a valve for use in the flow of oil in pipe lines or wells and which included valve stems *machined* with a triangular enlarge-

ment. The manufacturing tolerances referred to there were from .002 of an inch to .015 which is an entirely different situation than the present case wherein the devices are cast and the nib and socket arrangement are not machined. The accused device is made to have clearance and allow flexibility just the same as the devices of the patent in suit.

Petitioners mention Claim 3 (Br., p. 79), but as that claim is not in suit it is not thought to be pertinent and reference will not be made to it.

Petitioners' reference to Claim 4 (Br., p. 80) states that this claim is substantially the same as Claims 1 and 2 and state that the same argument made with respect to Claims 1 and 2 applies to Claim 4. Reference to the chart (Plts'. Ex. 17), a chart of Claim 4, shows there are additional elements in Claim 4 over Claims 1 and 2 and particularly in elements 8 and 9 wherein it specifies a washer on the rod engaging the other end of the spring and a nut engaging the washer to compress the springs for retaining the tool in the ground and yielding in response to resistance on said tool when the plow is in operation to produce a pumping action of the tool in the soil.

Under the heading "Claims 5 and 6" petitioners (Br., p. 81) infer that Claims 5 to 8 are vague and indefinite and, therefore, the patent must be classed as a secondary or limited patent. The Court of Appeals of the Fifth Circuit passed upon both of these points and particularly stated (R. 1364):

> "The further contentions that the Graham patent was void because of 'vague and indefinite specifications and claims,' and because 'the claims are much broader than the specifications and any invention disclosed thereby,' are without merit, for appellants' expert, Fishleigh, admitted that anyone skilled in the art could construct an operative device in accord-

ance with the teachings of the patent claims, and (fol. 1366) a review of them convinces us that they are no broader than reasonably necessary to support the combination claimed."

The same contention was made in the trial court and the court of appeals that the patent was a secondary or improvement patent in a crowded field and entitled to protection only within the narrowest limits, but such contention was rejected. The court of appeals said, in its opinion (R. 1364), that testimony of Graham and his expert, Fenton, that each and every element of Claims 1, 2, 4, 5, 6, 7, and 8 of the Graham patent with minor structural variations or the substitution of mechanical equivalents is exemplified in the Jeoffroy structure, justified a finding of infringement, particularly in view of the benefit of the District Court of a demonstration or view of both devices in actual simultaneous operation, even though the trial court took into the consideration petitioners' complaint that the test was not conducted under the most favorable circumstances.

The court of appeals further found (R. 1366) that the trial court did not err in its holding of longitudinal movement of the shank in the accused structure and in the trial court's holding of infringement stating that it is the claims which measure the invention as many times held by this Court (*Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 419, 52 L. Ed. 1122), and others, citing *Graver Tank & Mfg. Co., Inc.*, v. *Linde Air Products Co.*, 339 U. S. 605, 608, 94 L. Ed. 1097, 1101, 70 S. Ct. 854; *Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.*, 10 Cir., 97 F. 2d 945, 947; *Hunt* v. *Armour & Co.*, 7 Cir., 185 F. 2d 722, 728, and finally holding (R. 1367) that in view of the trial court's findings based on a demonstration of the Graham and Jeoffroy devices in actual opera-

tion, it could not say that the trial court's finding of infringement is clearly erroneous.

Petitioners (Br., pp. 81, 82) say that elements 5 and 8 of Claims 5 and 6 are not found in the accused devices and particularly because of the recitation that the shank has an end portion between the movable and fixed part and in movable engagement with said parts. The accused devices do have a forward end of the shank between the fixed portion of the clamp and the fulcrum plate. Petitioners argue that the shank is not in movable engagement, stating that the slight longitudinal movement of the shank referred to in the specification is not present in the accused devices, but as previously stated it is the claims that measure the invention and the claims do not specify longitudinal movement. The claims have reference to any movement of the shank in respect to the parts and it cannot be denied that in the accused devices the shanks move away from the upper or fixed part of the clamp when the device is in operation. The shank of the accused device has movement and these parts are fixed together and operate substantially in the same manner as the parts of the device of the patent in suit and as called for in the claims.

Petitioners (Br., pp. 82, 83 and 84) contend that the movement referred to in Claims 5 and 6 would be longitudinal movement but the claims are not so limited and both the trial court and the court of appeals so held. Of course, any movement the shank has with respect to the fulcrum plate and bracket or fixed part would answer to the letter of the claims and this definitely could mean lateral or vertical movement as well as longitudinal movement. Both the trial court and court of appeals studied the history of the application of the patent in suit through the Patent Office and held that Claims 5 and 6 were not

limited to longitudinal movement as the petitioners contend.

Petitioners then say (Br., p. 85) that even if the claim is speaking of vertical movement of the shank relative to the fulcrum member that such movement is not present in the accused device. However, the fallacy of this argument is clear when it is noted that the springs on the rods of the accused device hold the shank and fulcrum member together so that the nibs and socket arrangement perform the same function of the single bolt through the shank and fulcrum member in the Graham structure. Here again petitioners argue that the only longitudinal movement in the accused device is that of manufacturing tolerances and as this has heretofore been referred to argument will not be repeated.

Respondents respectfully submit that the movement referred to in the claim is not limited to movement of the shank with respect to the fulcrum member as argued by petitioners (Br., p. 84). Any movement at all between the shank and the fulcrum member and fixed part would answer to this claim and when it is considered that in movement of these plows through the field the strain on the shank would be considerable, particularly when encountering rocks underneath the top of the ground and there is bound to be movement between the shank and the fulcrum plate, even though this movement is slight, and in no instance great enough to disengage the nib from the socket in the accused device, because of the character of the forces acting on the fulcrum member and shank. It is submitted, therefore, that the accused devices include elements 5 and 8 as called for in Claims 5 and 6.

Under the heading "Claims 7 and 8" petitioners (Br., p. 87) admit that Claim 8 is substantially similar to Claim 7 except for element 8 regarding the stop engagement of

the shank relatively to the clamping portion of the hinged clamping member when the shank is under rocking movement. They argue (Br., p. 88) that this is not shown in the Graham device. This statement is clearly an error because the rods extend through the shank and also through one of the fixed clamping members and the counterpart in petitioners' device is a socket and nib arrangement on the fixed clamping members and the shank. As this point is the only difference argued by petitioners to relieve them of infringement of Claims 7 and 8, respondents respectfully submit that such argument is unfounded and the claims are clearly infringed as found by the trial court and the Court of Appeals of the Fifth Circuit. The trial court, having considered the evidence in detail including an actual field test of the accused device and the device of the patent in suit and having found the accused devices infringed upon the claims of the patent here in suit and the court of appeals having affirmed such opinion, the findings of the trial court should not be disturbed. There has clearly been no error shown in such findings. Petitioners, here, are merely asking this Court to make a review to determine if the findings of fact are properly substantiated by the evidence.

To review the case upon this issue would decide no special or important question and would involve merely the review of the comprehensive findings of fact of the lower court and the voluminous record to see whether or not these findings are justified by the evidence.

CONCLUSION.

In conclusion it is respectfully submitted the petition for writ of certiorari asserts no grounds upon which the writ should be granted. The lower courts carefully considered the decision of this Court in the A. & P. case in making their findings and conclusions. Denial of the petition is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF SERVICE.

Two copies of the foregoing Respondent's Brief in Opposition to Petition for Writ of Certiorari have been sent by United States mail, postage prepaid, to W. W. Gibson and S. Tom Morris, 630 Amarillo Building, Amarillo, Texas, Attorneys for Petitioners, this 20 day of January, 1954.

Attorney for Respondents.

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FILED
MAR 22 1954
HAROLD B. WILLEY, C

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1953

No. 519

JEOFFROY MFG. INC., ROY JEOFFROY AND RAY L. JEOFFROY, Petitioners,

versus

WILLIAM T. GRAHAM AND GRAHAM-HOEME PLOW CO., INC., Respondents.

PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI

W. W. GIBSON AND
S. TOM MORRIS
630 Amarillo Building
Amarillo, Texas
ATTORNEYS FOR PETITIONERS

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PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI

TO THE UNITED STATES SUPREME COURT AND THE JUSTICES THEREOF:

Petitioners, Jeoffroy Mfg. Inc., et al, respectfully pray for a rehearing and reversal of the order hereinbefore entered on the 8th day of March, 1954, denying their petition for writ of certiorari to the United States Court of Appeals for the Fifth Circuit, on the following grounds:

I. *Substantial Matter Not Previously Presented.*

A. Improbability of Conflicting Decisions.

Petitioners and Respondents reside and have their places of business in Amarillo, Texas. They have been since about 1937 and are now the principal manufacturers of chisel plows in the United States. The chisel plow manufacturing business is thus concentrated not only in the Fifth Circuit but also within the Northern District of Texas, Amarillo Division. There is not, therefore, any real likelihood that there will be litigation of Graham Patent No. 2,493,811 in another circuit and consequently no likelihood of conflicting decisions with respect to said patent. Under such circumstances certiorari should be granted. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 50, 83 L. Ed. 34, 59 S. Ct. 8 (1938); *Muncie Gear Works v. Outboard, M. & Mfg. Co.*, 315 U.S. 759, 765, 86 L. Ed. 1171, 62 S. Ct. 869 (1941).

In the *Schriber* case, at p. 50, Mr. Justice Stone for the court said:

> "We . . . granted certiorari . . . on a petition for rehearing showing that, notwithstanding the questionable validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit."

And in the *Muncie* case, at p. 765, Mr. Justice Jackson said:

> "While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely."

The nature of the substantive questions involved is set out in Petitioners' original petition and brief. Those questions, coupled with the improbability of conflicting decision, in the light of the above cases, present valid ground for certiorari.

B. Concurrent Finding Rule Inapplicable.

The Trial Court found invention based upon "structural novelty in the fulcrum assembly and even greater merit in the reputed suitability of such structure for digging a scalloped pattern through the plowed earth," (R. 16), which considerations the court held "save this patent from the condemnation of" the *A & P* case. (R. 17) Novelty was detailed in the court's letter to counsel. (R. 1359, footnote 6, and Appendix "A", p. 91 of Petitioners' original brief herein.) The Court of Appeals for the Fifth Circuit approved generally but not specifically the Trial Court's findings of novelty, saying:

> "While these findings are ably and clearly expressed, it is not necessary that we find the Graham Patent to possess novelty in each and every respect mentioned." (R. 1360, last paragraph of footnote 6.)

The Court of Appeals further said:

> "Independently of those findings (of novelty), we think the evidence fairly establishes that the patentee, Graham, was the first to perfect the idea of resilient and frictional engagement of the shank of a ground working tool between a fixed part and a movable part, or between the bracket on the H-beam and the fulcrum plate pivotally mounted on the bracket. His production of an efficient mounting for a ground working tool shank that would permit it to rock or vibrate, and yet obviate the

necessity of it being hinged directly on a fixed member, as in the Valley City device and the prior art, was novel both in method of operation and result accomplished, and, we think, entitled him to a valid patent on the combination claimed. The Graham patent may not here be invalidated under the tests for invention laid down in the *A & P Tea Co.* case, *supra,* since that case involved only uniting old elements 'with no change in their respective functions', whereas the patent here involved combines both old and new elements to produce a new result." (R. 1363)

The findings upon which the two courts below sustain invention and validity are not concurrent findings. They are separate findings with little relation to each other. Further, neither court has made specific findings of validity with respect to the individual claims; each has rather made a blanket finding of validity as to the entire patent. In this connection we point out that one of the features settled upon by each of the courts below as sustaining validity is not found in any of the claims of the patent.

The Trial Court relied in part on the suitability of the structure for digging a scalloped pattern through the earth. That result is described (R. 1028, col. 4, l. 44-53 and R. 1029, col. 5, l. 69-col. 6, l. 5) but not claimed. Pumping action, which produces the scalloped pattern, is both described and claimed, but Respondents' expert testified that while such action is a result of the structure, it "is not an essential part of the patent." (R. 994-995)

The Court of Appeals settled on resilient and frictional engagement of the shank between a fixed part and a movable part, obviating the necessity of direct hinging of the shank on

a fixed member. The patent speaks of frictional engagement or resistance one time (R. 1029, col. 5, l. 57); it does not speak of obviating direct hinging at all. The claims are silent as to both of those features.

Two things are clear: (1) Each court below has made separate findings upon which it bases a conclusion of invention. (2) None of the claims as drawn define the alleged invention in terms of *scalloped pattern, frictional engagement* or *nondirect hinging,* thus the findings of each court upon which it bases invention relate to some matters not found in the claims at all. For those reasons the concurrent finding rule is inapplicable and certiorari should be granted. *Altoona Pub. Theatres v. Am. Tri-Ergon Corp.*, 294 U.S. 477, 480, 487, 79 L. Ed. 1005, 55 S. Ct. 455 (1934).

II. *Intervening Circumstances of Substantial Effect.*

On February 10, 1954, after the original petition for certiorari was filed herein, the District Court for the Northern District of Texas, Amarillo Division, entered judgment in Civil No. 1469, *Jeoffroy Mfg., Inc. v. William T. Graham,* which is in conflict with the decision of the Fifth Circuit in the instant case. (A copy of the judgment in No. 1469 is attached to this petition as Appendix "A". There is no published opinion.)

After the decision of the Trial Court on September 30, 1951 in the instant case (R. 14), Petitioner, Jeoffroy Mfg., Inc., redesigned its spring trip by placing the shank underneath the hinge member and bolting the two parts solidly together, thus directly and fixedly attaching the shank to the hinge member, eliminating all clamping action of the hinge member upon the shank, eliminating any frictional engage-

ment of the shank with the hinge member, and eliminating movable engagement of the shank with the hinge member.

The Trial Court held that the new Jeoffroy structure does not infringe claims 1, 2, 3, 4, 7 and 8 but does infringe claims 5 and 6 of Patent No. 2,493,811. That holding with respect to claims 5 and 6 is squarely in the teeth of the decision of the Fifth Circuit in the instant case wherein, as we have pointed out in I. B. above, the court emphasized as invention the resilient and frictional engagement of the shank between a movable part and a fixed part thereby obviating the necessity of direct hinging of the shank.

This recent decision of the Amarillo Division of the District Court for the Northern District of Texas in Civil No. 1469 emphasizes the uncertainty that results from the opinion of the Fifth Circuit in the case at bar and the importance of review by the Supreme Court.

Respectfully Submitted,

W. W. GIBSON AND
S. TOM MORRIS
630 Amarillo Building
Amarillo, Texas
ATTORNEYS FOR PETITIONERS

By W. W. GIBSON

CERTIFICATE

I hereby certify that the above petition for rehearing is presented in good faith and not for delay, that it is limited to the grounds above specified as provided by Rule 33 (2) of the Rules of the Supreme Court, and that two copies of this petition have been sent by United States mail, postage prepaid, to Clayton Heare, Amarillo Building, Amarillo, Texas, and Claude A. Fishburn and Orville O. Gold, 1217 Commerce Trust Building, Kansas City, Missouri, attorneys for Respondents.

Dated March 19th, 1954.

W. W. GIBSON

Attorney for Petitioners

APPENDIX "A"

IN THE DISTRICT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF TEXAS, AMARILLO DIVISION

JEOFFROY MFG., INC.,
Plaintiff,
VS.
WILLIAM T. GRAHAM,
Defendant.
CIVIL ACTION NO. 1469

JUDGMENT

This cause having been tried upon proceedings in open Court without jury upon the original complaint for Declaratory Judgment and the defendant's second amended answer and counterclaim or cross action and plaintiff's reply to said counterclaim, and the Court having heard and considered the evidence, the briefs and argument of counsel, and the Court being fully advised in the premises, it is

ORDERED, ADJUDGED and DECREED, as follows:

1. The Graham patent No. 2,493,811 is good and valid in law; William T. Graham was the first, true and original inventor of the invention, improvement and combination disclosed in said patent; and defendant, William T. Graham, is the lawful owner of the entire right, title and interest in and to said invention.

2. Plaintiff, Jeoffroy Mfg., Inc., has infringed claims 5 and 6 of patent No. 2,493,811.

3. Plaintiff, Jeoffroy Mfg., Inc., its officers, confederates, associates, servants, attorneys, agents, clerks and workmen, and every person acting for or on behalf of said plaintiff, are hereby perpetually enjoined and restrained from directly or indirectly making or causing to be made, selling or causing to be sold, using or causing to be used, any device embodying the inventions defined by claims 5 and 6 of the Graham patent No. 2,493,811.

4. Plaintiff has not infringed claims 1, 2, 3, 4, 7 and 8 of Graham patent No. 2,493,811.

5. The Graham patent No. 2,627,798 is invalid and the defendant's counterclaim or cross action is dismissed as to said patent.

6. The defendant, W. T. Graham, shall recover from the plaintiff, Jeoffroy Mfg., Inc., for infringement of patent No. 2,493,811, general damages, as well as all further recovery authorized by law and that may be hereafter awarded in the discretion of the Court, and the said plaintiff, its officers, agents, clerks and employees shall submit to such oral examination as may be directed, and shall preserve and produce, as ordered, all of said plaintiff's books, vouchers, accounts and other documents relating in anywise to said infringement.

7. The Court retains and reserves jurisdiction for the purpose of ascertaining and fixing the amount of general damages, as well as all further recovery authorized by law and that may be awarded in the discretion of the Court, in favor of the Defendant and against the said plaintiff, and for the purpose of fixing and taxing the costs and the amount thereof to be paid by the respective parties.

Signed this 10th day of February, 1954.

/s/ Jos. B. Dooley
United States District Judge

APPROVED AS TO FORM:

/s/ S. Tom Morris
Of Counsel for Plaintiff

/s/ Clayton Heare
Of Counsel for Defendant

17

Office - Supreme Court, U.S.
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In the Supreme Court of the United States

October Term, A.D., 1953.

No. 519.

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vs.

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Respondents.

RESPONDENTS' RESPONSE TO PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI.

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Respondents.

RESPONDENTS' RESPONSE TO PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI.

May It Please the Court:

Respondents, in this response to petition for rehearing after denial of certiorari filed by the petitioners, will refer to the points raised by petitioners in their petition in the order named therein.

I.

"Substantial matter not previously presented."

A. "Improbability of conflicting decisions."

Petitioners in their brief (p. 2) state that "the chisel plow manufacturing business is thus concentrated not only in the Fifth Circuit but also within the Northern District of Texas, Amarillo Division."

This is an erroneous statement. This Honorable Court no doubt knows that the manufacture of farm equipment is not concentrated in the Fifth Circuit. There are many large plow manufacturers located outside of the Fifth Circuit, many of whom manufacture chisel type plows at the present time.

Respondents' attorney has, since the receipt of the petitioners' petition, inspected a copy of the Implement and Tractor Index to Product Information of December 19, 1953. This publication lists under the heading of "Plows" in excess of one hundred companies as manufacturers of or dealers in plows, including the following:

J. I. Case Company, Racine, Wisconsin (Seventh Circuit).
Athens Plow Co., Athens, Tennessee (Sixth Circuit).
Oliver Corporation, South Bend, Indiana (Seventh Circuit).
Love Tractor Co., Eau Claire, Michigan (Sixth Circuit).
Taylor Implement Company, Athens, Tennessee (Sixth Circuit).

Respondents state that the following companies, large manufacturers of farm equipment of various types, also make chisel plows at the present time:

Allis-Chalmers Manufacturing Co., Milwaukee, Wisconsin (Seventh Circuit), with factories at

Athens, Tenn. (Sixth Circuit); La Porte, Ind. (Seventh Circuit); Oxnard, Calif. (Ninth Circuit), and sales office at Kansas City, Missouri (Eighth Circuit).

Massey-Harris Company, Racine, Wisconsin (Seventh Circuit).

John Deere Plow Co., Moline, Illinois (Seventh Circuit); factories in Syracuse, N. Y. (Second Circuit); Los Angeles, California (Ninth Circuit); Dubuque, Iowa (Eighth Circuit).

Cockshutt Farm Equipment, Ltd., Bellevue, Ohio (Sixth Circuit).

Krause Manufacturing Company, Hutchinson, Kansas (Tenth Circuit).

The Tractor and Implement Index above referred to shows a listing under the heading, "Plows—Chisel and Sub-Soil," page 357, twenty-three names listed as manufacturers of or dealers in such plows, some of whom are the following:

Atlas Scrapper & Engineering Company, Bell, California (Ninth Circuit).

Baraboo Manufacturing, Inc., Baraboo, Wisconsin (Seventh Circuit).

Cheney Weeder Co., Cheney, Washington (Ninth Circuit).

Glencoe Manufacturing Co., Glencoe, Minnesota (Eighth Circuit).

International Harvester Company, Chicago, Illinois (Seventh Circuit).

Kirkendahl Plow Co., Newkirk, Oklahoma (Tenth Circuit).

Vassar Manufacturing Co., Perkins, Oklahoma (Tenth Circuit).

Western States Equipment Co., Golden, Colorado (Tenth Circuit).

It is very likely that many of the plow companies located in other circuits as shown above and particularly in the

Sixth, Seventh, Eighth, Ninth and Tenth Circuits, who are not now manufacturing and selling chisel type plows, may enter into that field, and particularly is it true that a large majority of the plow manufacturing industry is located in the Sixth and Seventh Circuits.

From the above it is clear that the plow industry is not concentrated in the Fifth Circuit as alleged by petitioners, as was the automobile industry in the *Schriber-Schroth Co.* v. *Cleveland Trust Co.* case, 305 U. S. 47, 50, 83 L. Ed. 34, 59 S. Ct. 8, nor does the patent dominate a substantial portion of an industry so concentrated in the Fifth Circuit that litigation in other circuits resulting in a conflict of decisions is unlikely as was the situation in the case of *Muncie Gear Works* v. *Outboard M. & Mfg. Co.,* 315 U. S. 759, 765, 86 L. Ed. 1171, 62 S. Ct. 869, both of which cases are relied on by petitioners in support of this point in their petition for rehearing.

Respondents submit the petitioners' point of improbability of conflicting decisions is not supported by the facts and since the chisel plow manufacturing industry is not concentrated in the Fifth Circuit, the Schriber and Muncie cases are not in point.

B. "Concurrent finding rule inapplicable."

Under this heading the petitioners attempt to show that this point was not heretofore considered.

Reference to the trial court's and the Court of Appeals for the Fifth Circuit's opinion was made in petitioners' brief in support of its petition for certiorari under Point D, "Findings of Validity" (pp. 11 and 12), and again at pp. 17, 18 and 19), wherein it is stated that the trial court held there was novelty in the fulcrum assembly as well as in the suitability of the structure for digging a scalloped pattern through the plowed earth. The Court of Appeals

adopted these findings of the trial court, but set out its additional reasons for holding of novelty of the device of the patent in suit and distinguished it from the A & P case. Now the petitioners attempt to say that the two lower courts are in conflict in their decisions. Such is not a true statement of the facts. Nowhere in the opinion of the Court of Appeals for the Fifth Circuit did it disagree with the findings of the trial court.

Petitioners, in their petition for rehearing (p. 4), state that neither of the lower courts has made specific findings of validity with respect to the individual claims, and that features settled on by each of the courts below as sustaining validity are not found in any of the claims of the patent.

Apparently the petitioners are referring to the mention of a scalloped pattern by the trial court. The claims of the patent are not directed to a result and, therefore, do not mention a "scalloped pattern." They properly define a structure which results in a scalloped pattern in the earth, to which the trial court was referring. The trial court clearly found novelty in the fulcrum assembly structure which is specified in each of the claims of the patent in suit and this is a point of novelty of such claims.

The Court of Appeals did not say the trial court was wrong in holding novelty in the fulcrum assembly. Apparently petitioners criticize the Court of Appeals because it made reference to *resilient* and *frictional* engagement of the end of the shank of the plow by the fulcrum member and bracket part of the clamp (R. 1363). The claims, and particularly claims 5 and 6 (R. 1030), refer to the shank being held between the fulcrum member and bracket in their "resiliently held together asssociation" so that when the shank is rocked or moved the end portion of the shank between the parts will cause the movable part of the clamp to move away from the fixed part, the end

portion of the shank being contactingly held between the two parts. Some of the other claims mention the clamping of the end of the shank between the movable part and the fixed part of the clamp. Respondents respectfully submit, therefore, that there is ample support in the claims for the Court of Appeals' reference to resilient and frictional engagement of the end of the shank between a fixed part and a movable part.

It is further clear that there is no conflict in the decisions of the two lower courts by a reading of the opinion of the Court of Appeals for the Fifth Circuit (R. 1363), where it was stated:

> "• • • Without detailing its structural features at great length, it seems to us that, from the evidence and the various exhibits, the District Court was justified in its findings of novelty in the Graham fulcrum assembly and its unique method of operation. • • •"

Then the Court of Appeals for the Fifth Circuit pointed out "independently of those findings" that there was additional novelty in the Graham invention (R. 1363-4).

The present case distinguishes from the *Altoona* case (294 U. S. 477, 480, 487, 79 L. Ed. 1005, 55 S. Ct. 455) relied upon by petitioners (p. 4), because there the only point of novelty in the patent in suit was not found in any of the claims. In the present case both courts found novelty in the Graham fulcrum assembly.

There clearly were concurrent findings by the trial court and the Court of Appeals for the Fifth Circuit and this point of petitioners' petition for rehearing has no basis in the record.

II.

"Intervening circumstances of substantial effect."

Under this heading, petition page 5, petitioners have set forth the decision of the District Court for the Northern District of Texas, Amarillo Division, in another case between substantially the same parties, Civil No. 1469, recently decided by said court wherein petitioners alleged that such ruling is in conflict with the decision of the Fifth Circuit in the present proceeding and again proceeds to set forth an alleged state of facts in that case which are not in the present case.

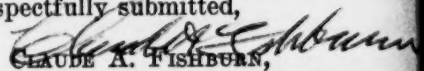
Such a set of facts do not constitute intervening circumstances of substantial effect referred to in Rule 33 (par. 2) of the rules of this Court. This Court cannot decide whether or not the trial court was wrong in a later case where the facts of said case are not before this Court. This Honorable Court cannot attempt to decide facts not before it and the only facts before it are those in the present record. What the same trial court holds in a later case has no bearing on the Court of Appeals' opinion or this Court's opinion in the present case. If the trial court in the second case made an error, then the time for this Court to correct that error is when such case properly comes before it on writ of certiorari.

In conclusion, it is respectfully submitted that petitioners have not brought forth in their petition for rehearing intervening circumstances of substantial or controlling effect or other substantial grounds available to petitioners, although not previously presented, as provided in the rules of this Court.

Respondents again submit that petitioners are merely seeking to have the Supreme Court provide a third review of the evidence to determine whether the findings of fact are properly substantiated by the evidence.

The petition for rehearing should be denied.

Respectfully submitted,



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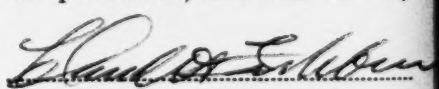
Certificate of Service.

Two copies of the foregoing response to petitioners' petition for rehearing after denial of certiorari have been sent by United States mail, postage prepaid, to W. W. Gibson and S. Tom Morris, 630 Amarillo Building, Amarillo, Texas, attorneys for petitioners, this 26 day of March, 1954.



Attorney for Respondents.